IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Bruce Eisen et al.
Assignee:	User Trends, Inc.
Title:	Electronically Distributing Promotional And Advertising Material Based Upon Consumer Internet Usage

Serial No.:	09/379,167	Filing Date:	08/23/99
Examiner:	John L. Young	Group Art Unit:	3622
Docket No.:	M-7729 US		

TRANSMITTAL LETTER FOR REPLY BRIEF

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Alexandria, VA 22313-1450

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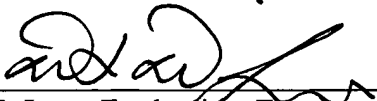Please find enclosed an original of the Reply Appeal Brief and the Claim and Exhibit Appendices.

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Respectfully submitted,
Century IP Law Group

Date: February 25, 2005

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Dear Sir:

INTRODUCTION

Pursuant to 37 CFR 41.39(b), "If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options" (1) reopen prosecution or (2) maintain appeal by filing a reply brief as set forth in 37 CFR 41.41. Accordingly, the Applicant hereby requests for the appeal to be reinstated and provides this Reply Brief, herewith, in compliance with 37 CFR 41.39(b), and to address issues and arguments in Examiner's Answer.

The time to file this reply has been extended to March 1, 2005, per Examiner John Young's agreement to restart the 2-month time period to file this reply due to delays associated with receiving the Examiner's Answer. (See interview summary and correction letter of 01-12-05).

I.   REAL PARTY IN INTEREST

The real party in interest is UserTrends, Inc. 1801 Avenue of the Stars, Suite 929, Los Angeles, CA 90067.

II.   RELATED APPEALS AND INTERFERENCES

There are no related Appeals or Interferences.

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III. STATUS OF CLAIMS

Claims 1-52 and 75-82 are currently pending in the Application. The appeal is directed to the rejection of claims 1-52 and 75-82, a copy of which appears in the Appendix Of Claims on Appeal attached to the Appeal Brief, as filed.

IV. STATUS OF AMENDMENTS

No Amendment has been filed in response to the last rejection of the Examiner in Paper #33.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Briefly, the present invention relates to a novel system for electronically tracking web pages visited by a previously identified user, without requiring the user to provide any further personal or identifying information to the system. To accomplish this, the system sends an email message to the identified user. The email contains a link to a web page, and specifically embedded in the link is a "unique identifier" for identifying the particular user.

Referring to page 16, lines 11-21, an example of a link 606 is shown in Figs. 6B, 6C namely "http:www.mystore.com/?XXXX". (Figs. 6B, 6C are attached to the Appeal Brief as **Exhibit 1**). A first portion of the link 606 "http:www.mystore.com/" constitutes the web page address. A second portion of the link 606 "XXXX" constitutes the unique identifier.

Referring to page 17, lines 10-24 and Fig. 7A (attached as **Exhibit 2** to the Appeal Brief), when the user selects the link 606 in the email, then the single act of selecting the link 606 results in the following:

(1)   the system forwards the link 606
        ("http:www.mystore.com/?XXXX") to a server computer hosting the
        web page;

(2)   the server computer sends the web page data (for
        "http:www.mystore.com") to the user's browser for display; and

(3)   the server computer records the unique identifier ("XXXX") in a
        log 700 in association with the web page address and other related
        details (IP Address 701, Log Time 702, unique identifier 703, etc.),
        as shown in Fig. 7A.

Accordingly, the multiple entries in the log 700 and the related details provide accurate and concise information about the particular web pages visited by the user, the IP address 701 of the user's computer, the duration of time 702 the user visited each web page, etc. Each entry in the log 700 can be directly traced to a particular user because the unique identifier 703 for that user is recorded in the log 700 in association with that entry. As such, the system can analyze the log 700 records to build user profiles based on the detailed information in each entry.

It is noteworthy that unlike the prior art references cited, the above-mentioned three functions can be performed without the need for a "dedicated server" (e.g., email sensor server). That is, the web-hosting server inherently captures and records all the needed detailed information in a log, without requiring active registration of the individual, or reliance on any intrusive profiling mechanisms (e.g., cookies) that require read/write access to the "client computer," or substantial communications and operational overhead.[1]

The particular privacy sensitive features and technological advantages of the tracking method of the present invention in contrast to the inconvenient and intruding features of prior art consumer profiling systems are fully disclosed in <u>Declaration of Bruce Eisen</u>, CEO of UserTrends, Inc., and <u>Declaration of James Fedolfi</u>, VP of eContacts, Inc., attached as **Exhibit 3** to the Appeal Brief. Said under oath executed declarations are submitted as objective evidence of non-obviousness, pursuant to MPEP Section 716. The board is hereby requested to review and consider the declarations.

Independent claim 1 is directed to a method for electronically identifying a consumer without requiring consumer registration, the method comprising: embedding a unique identifier within a web site address, the unique identifier uniquely identifying an email recipient; including the web site address in an electronic mail message sent to the email recipient, wherein the web site address provides the email recipient with access to one or more web sites; establishing a connection between a client computer used by the email recipient to receive the email and a server computer providing access to the one or more web sites, in response to the email recipient selecting a reference to the web site address included in the electronic mail message; providing the unique identifier to the server computer by way of sending the web site address to the server computer in a request submitted by the client computer to access said one or more web sites, independent from any consumer profile information previously stored on the client computer; parsing the web site address in the request, to retrieve the unique identifier embedded in the web site address; identifying the email recipient based on the retrieved unique identifier; and tracking the email recipient's movement within the one or more web sites by associating the unique identifier with

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[1] See <u>Declaration of Bruce Eisen</u>, and <u>Declaration of James Fedolfi</u>, attached herewith as Exhibit 3 to the Appeal Brief.

information that defines consumer activity within said one or more web sites.

Independent claim 22 is directed to a computer executable process stored in a computer readable medium for identifying a consumer without requiring consumer registration, the process comprising: embedding a unique identifier within a web site address, the unique identifier uniquely identifying a consumer; establishing a connection between the consumer's computer and a server computer providing access to one or more web sites, in response to a consumer selecting a reference to the web site address forwarded by way of electronic mail; providing the unique identifier to the server computer by way of sending the website address to the server computer to access the one or more web sites, independent from any consumer profile information previously stored on the client computer; parsing the web site address to retrieve the unique identifier embedded in the web site address; and tracking the consumer's movement within the one or more web sites by associating the unique identifier with information that defines consumer activity within said one or more web sites.

Independent claim 45 is directed to a method for electronically identifying a consumer without requiring consumer registration, the method comprising: receiving a consumer request to access one or more web sites implemented on at least one server computer, wherein the consumer request is submitted by way of a client computer and the request includes a web site address, sent to the consumer in an electronic mail message, with a unique identifier embedded in the web site address for uniquely identifying the particular consumer; parsing the web site address to find the unique identifier; and logging the unique identifier in one or more log files in association with information that defines consumer activity within said one or more web sites, independent from any consumer profile information previously stored on the client computer by any servers.

Independent claim 52 is directed to a unique identifier embedded in a URL provided to a consumer by way of electronic mail, such that when the consumer selects the URL, a connection is established between a consumer computer having a first IP address and a web server providing access to one or more web sites, wherein the web server receives the URL via said established connection independent from any consumer profile information previously stored on the client computer, wherein the web server parses the URL for the unique identifier, and wherein the IP address is recorded in a log file in association with the unique identifier.

Independent claim 75 is directed to a computer-implemented method for electronically tracking web pages visited by an email recipient without requiring advanced registration, the method comprising: embedding a unique identifier within a uniform resource locator (URL), the unique identifier uniquely

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identifying an email recipient, the URL identifying one or more web pages; including the URL in form of a link in an email sent to the email recipient, wherein selecting the link provides the email recipient with access to the one or more web pages; establishing a connection between a server computer and a client computer used by the email recipient to receive the email, in response to the email recipient selecting the link, wherein the server computer provides access to the one or more web pages identified by the URL; providing the unique identifier to the server computer by way of a request submitted by the client computer to access said one or more web pages, independent from any profile information previously stored on the client computer, wherein the request includes the URL in which the unique identifier is embedded; parsing the URL in the request to retrieve the unique identifier embedded in the URL; identifying the email recipient based on the retrieved unique identifier; automatically storing the unique identifier in association with the IP address of the client computer in a log file of the server computer; and automatically storing access information about the one or more web pages visited by the email recipient in association with the IP address of the client computer in the log file of the server computer.

Independent claim 78 is directed to a computer system for electronically tracking web pages visited by an email recipient without requiring advanced registration, the system comprising: means for embedding a unique identifier within a uniform resource locator (URL), the unique identifier uniquely identifying an email recipient, the URL identifying one or more web pages; means for including the URL in form of a link in an email sent to the email recipient, wherein selecting the link provides the email recipient with access to the one or more web pages; means for establishing a connection between a server computer and a client computer used by the email recipient to receive the email, in response to the email recipient selecting the link, wherein the server computer provides access to the one or more web pages identified by the URL; means for providing the unique identifier to the server computer by way of a request submitted by the client computer to access said one or more web pages, independent from any profile information previously stored on the client computer, wherein the request includes the URL in which the unique identifier is embedded; means for parsing the URL in the request to retrieve the unique identifier embedded in the URL; means for identifying the email recipient based on the retrieved unique identifier; means for automatically storing the unique identifier in association with the IP address of the client computer in a log file of the server computer; and means for automatically storing access information about the one or more web pages visited by the email recipient in association with the IP address of the client computer in the log file of the server computer.

Independent claim 81 is directed to a computer-readable medium comprising a computer-executable process stored for electronically tracking web pages visited by an email recipient without requiring advanced registration, the computer-executable process comprising: embedding a unique

identifier within a uniform resource locator (URL), the unique identifier uniquely identifying an email recipient, the URL identifying one or more web pages; including the URL in form of a link in an email sent to the email recipient, wherein selecting the link provides the email recipient with access to the one or more web pages; establishing a connection between a server computer and a client computer used by the email recipient to receive the email, in response to the email recipient selecting the link, wherein the server computer provides access to the one or more web pages identified by the URL; providing the unique identifier to the server computer by way of a request submitted by the client computer to access said one or more web pages, independent from any profile information previously stored on the client computer, wherein the request includes the URL in which the unique identifier is embedded; parsing the URL in the request to retrieve the unique identifier embedded in the URL; identifying the email recipient based on the retrieved unique identifier; automatically storing the unique identifier in association with the IP address of the client computer in a log file of the server computer; and automatically storing access information about the one or more web pages visited by the email recipient in association with the IP address of the client computer in the log file of the server computer.

No means or step plus function language has been used in either the independent or dependent claims pending for review on appeal with the exception of claims 78 and 79. Referring to pages 10-14 and Figures 1, 2, and 3 of the application, the means recited in claims 78 and 79 correspond to the following components of a communication network individually, collectively, and to their structural or functional equivalent, *without limiting the scope of the invention to such particular structures*:

> "a host computer 10, a monitor 11, and a printer 12. Monitor 11 may be a CRT type, a LCD type, or any other type of color or monochrome display. Printer 12 may be any type of printer such as an inkjet printer, laser printer, thermal printer, dot matrix, or the like for printing Internet documents. Also provided with computer 10 is a keyboard 13 for entering text data and user commands, and a pointing device 14 for processing objects displayed on monitor 11. Computer 10 includes a computer-readable memory medium such as a rotating disk 15 for storing readable data. Besides other programs, disk 15 stores email programs, log files for tracking user movement within a web site, application programs including web browsers by which computer 10 connects to the Internet, accesses web pages, stores files on disk 15, displays data in those web pages on monitor 11, and print data on printer 12. Computer 10 can also access a computer-readable floppy disk storing data files, application program files, and computer executable process steps embodying the present invention or the like via a floppy disk drive 16. A CD-ROM interface (not shown) may also be provided with computer 10 to access application program files and data files stored on a CD-ROM. A modem, an integrated services digital network (ISDN) connection, or the like also provides computer 10 with an Internet connection 17 to the World Wide Web (WWW). The Internet connection 17 allows computer 10 to download device drivers, data files, image files, log files, application program files and computer-executable process steps embodying the present invention. Figure 2 is a block diagram showing the internal functional architecture of computer 10. As shown in Fig. 2, computer 10 includes a CPU 201 for executing computer-executable process steps and interfaces with a computer bus 209.

Also shown in Figure 2 are a printer interface 202, a WWW interface 203, a display device interface 204, a keyboard interface 205, a pointing device interface 206 and disk 15. As described above, disk 15 stores operating system program files, application program files, web browsers, log files and device drivers. Some of these files are stored on disk 15 using an installation program. For example, CPU 201 executes computer-executable process steps of an installation program so that CPU 201 can properly execute the application program. A random access main memory ("RAM") 207 also interfaces to computer bus 209 to provide CPU 201 with access to memory storage. When executing stored computer-executable process steps from disk 15 (or other storage media such as floppy disk 16 or WWW connection 17), CPU 201 stores and executes the process steps out of RAM 207. Read only memory ("ROM") 208 is provided to store invariant instruction sequences such as start-up instruction sequences or basic input/output operating system (BIOS) sequences for operation of keyboard 13. Figure 3 shows a topology of a computer network with computers similar to computer 10, connected to the Internet. For illustration purposes, only three computers X, Y and Z are shown connected to the Internet 302 via Web Interface 203 through a gateway 301, where gateway 301 can interface N number of computers. Web interface 203 may be a modem, network interface card or a unit for providing connectivity to other computer systems over a network using protocols such as X.25, Ethernet or TCP/IP, or any device that allows directly or indirectly, computer-to- computer communications. It is noteworthy that the invention is not limited to a particular number of computers. Any number of computers that can be connected to the Internet 302 or a network may be used.

Figure 3 further shows a second gateway 303 that connects a network of web servers 304 and 305 to the Internet 302. Web servers 304 and 305 may be connected with each other over a computer network. Web servers 304 and 305 can provide content to a user from database 306 and 307. Also shown in Figure 3 is a client side web server 308 that can be provided by an Internet service provider. Figure 4 shows the topology of a network that allows sending emails to consumers using computer 10, or a similar computer that can be connected to a network and/or the Internet. In Figure 4, computer 10 is connected to a mail server 402 via a communication server 401. Mail server 402 is connected to other computer networks including the Internet 302. Mail server 402 receives email messages with advertising and promotional materials and causes email messages to be sent to consumers with an email address."

The use of the above components provides the means for embedding a unique identifier within a uniform resource locator (URL), the unique identifier uniquely identifying an email recipient, the URL identifying one or more web pages; means for including the URL in form of a link in an email sent to the email recipient, wherein selecting the link provides the email recipient with access to the one or more web pages; establishing a connection between a server computer and a client computer used by the email recipient to receive the email, in response to the email recipient selecting the link, wherein the server computer provides access to the one or more web pages identified by the URL; providing the unique identifier to the server computer by way of a request submitted by the client computer to access said one or more web pages, independent from any profile information previously stored on the client computer, wherein the request includes the URL in which the unique identifier is embedded; parsing the URL in the request to retrieve the unique identifier embedded in the URL; identifying the email recipient based on the retrieved unique identifier; automatically storing the unique identifier in association with the IP address of

the client computer in a log file of the server computer; and automatically storing access information about the one or more web pages visited by the email recipient in association with the IP address of the client computer in the log file of the server computer.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Referring to Examiner's Answer pages, 7-10, claims 1-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capiel, US 6,449,634 (09/10/2002) [US f/d: 01/29/1999]. The Examiner contends as follows:

> "As per claim 1, Capiel (col. 12, ll. 53-61; and col. 13, ll. 10-25) discloses: A sensor server program with parameters E-mail address and unique mail code and member id.
>
> Capiel (col. 11, ll. 37-45; col. 11, ll. 50-67; and col. 12, ll. 1-50) discloses:
>
> > getClientIDCmd.CommandText=>select em_client_id from E-Mail_clients where name=?=
> > Set E-mailNameParm=getCliendIdCmd.CreateParameter (E-mailparm=,8,1)
> > GetClientIDCmd.Parameters.Append E-mailNameParm
> > getClientIDCmd(0)=broswerType. . . .
>
> Capiel (col. 1, ll. 43-67 and col. 2, ll. 1-24) discloses: The invention in addition tracks the responses of the E-mail clients to further refine the >visual media= group that responds positively to targeted advertisements with images. . . . the E-mail sensor server may . . . determine if a particular file format can be processed and displayed at the E-mail client.
>
> Capiel (col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) shows elements that suggest:
>
> A method for electronically identifying a consumer without requiring consumer registration, the method comprising: embedding a unique identifier within a web site address, the unique identifier uniquely identifying an email recipient; including the web site address in an electronic mail message sent to the email recipient, wherein the web site address provides the email recipient with access to one or more web sites; establishing a connection between a client computer used by the email recipient to receive the email and a server computer providing access to the one or more web sites in the electronic mail message; providing the unique identifier to the server computer by way of sending the web site address to the server computer in a request submitted by the client computer to access said one or more web sites, independent from any consumer profile information previously stored on the client computer; parsing the web site address in the request to retrieve the unique identifier embedded in the web site address; identifying the email recipient based on the retrieved unique identifier.

Capiel (col. 1, ll. 55-60) shows elements that suggest tracking the email recipients movement within the one or more web sites by associating the unique identifier with information that defines consumer activity within said one or more web sites; furthermore, Capiel performs the tracking without explicitly showing the use of cookies.

Capiel lacks an explicit recitation of providing the unique identifier to the server computer by way of sending the web site address to the server computer in a request submitted by the client computer to access said one or more web sites, independent from any consumer profile information previously stored on the client computer; parsing the web site address in the request to retrieve the unique identifier embedded in the web site address; identifying the email recipient based on the retrieved unique identifier.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Capiel (col. 4, ll. 52-67; col. 5, ll. 38-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-25; col. 11, ll. 4-67; col. 12, ll. 1-67; col. 13, ll. 1-25; FIG. 3A; FIG. 4; FIG. 5A; and FIG. 7) and particularly the disclosure of Capiel (col. 12, ll. 53-61; and col. 13, ll. 10-25) i.e., sensor server program with parameters E-mail address and unique mail code and member id and

Capiel (col. 11, ll. 37-45; col. 11, ll. 50-67; and col. 12, ll. 1-50) which discloses:

> getClientIDCmd.CommandText=>select em_client_id from E-Mail_clients where name=?=
> Set E-mailNameParm=getCliendIdCmd.CreateParameter (>E-mailparm=,8,1)
> AGetClientIDCmd.Parameters.Append E-mailNameParm
> getClientIDCmd(0)=broswerType. . . .

it would have been selected in accordance with providing the unique identifier to the server computer by way of sending the web site address to the server computer in a request submitted by the client computer to access said one or more web sites, independent from any consumer profile information previously stored on the client computer; parsing the web site address in the request to retrieve the unique identifier embedded in the web site address; identifying the email recipient based on the retrieved unique identifier because selection of such features would have provided means to identify the audience and tailor the advertising to that audience. (See Capiel (col. 1, ll. 22-24))."

Thus, the Examiner generally argues that based on "*common knowledge*" it would have been obvious to one of ordinary skill in the art to have modified the system disclosed in Capiel in the direction of the claimed invention. The Examiner, however, has not been able to provide any support for the rejection based on "common knowledge", despite numerous requests (in the prior responses, appeal brief, and supplemental appeal brief) by the Applicants, as mandated by MPEP §§2144.03 and 2143.

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VII. **ARGUMENT**

The arguments disclosed in the Appeal Brief, filed on 09/19/2003 (Paper #32) and the Supplemental Brief, filed on 3/23/2004, are hereby incorporated by reference herein in their entirety. The Examiner's rejections in the Examiner Answer and prior Office Actions, namely, Papers #27 and #33 cite the <u>same</u> single reference U.S. Patent 6,449,634 ("Capiel"), and propose the <u>same</u> arguments to reject the pending claims under 35 U.S.C. § 103(a). Therefore, the Applicant requests the Board to consider all arguments in the Appeal Brief and the Supplemental Brief in addition to arguments provided in this Reply Brief.

The Board is further requested to note that the prosecution of this matter has been unduly delayed, as the Patent Office has lacked enthusiasm to timely file an Answer to the Appeal Brief or Supplemental Brief by reciting any valid or conclusive grounds of rejection. Particularly, in response to the Appellants reinstatement of the appeal, the Examiner continues to cite to different portions of the same reference contending that "new grounds of rejection" have been found that require the prosecution in this matter to be reopened. A careful review of the newly filed Examiner Answer, however, lead the reader to the conclusion that no "new grounds" of rejection are present. That is, the Examiner Answer reiterates almost verbatim the arguments provided in the prior Office Actions and cites to the same sections of Capiel as previously cited by the Examiner.

The following chart provides the lengthy prosecution timeline in this matter. Note that there has been almost <u>6 years</u> since the filing of the application, and almost <u>3 years</u> since the filing of the Notice of Appeal.

08/23/99	Filing Date of the Application
04/23/03	Last Office Action Prior to Appeal
07/15/03	Filed Notice of Appeal
09/19/03	Filed Appeal Brief
01/27/04	PTO responded to Appeal Brief by Reopening Prosecution
03/23/04	Filed Supplemental Brief
12/28/04	Examiner's Answer Reopening Prosecution (after a 9-month lapse)

Referring to the Examiner Answer and also referring back to previous Office Action (i.e., Papers #27 and #33), each rejection includes numerous admissions that Capiel lacks explicit recitation of all the elements in the claims.[2] The Examiner alleges that such elements are "well known in the art." The record shows, however, that the Examiner, in violation of provisions of MPEP §2144.03, has failed to provide any

support whatsoever for said allegations, even where expressly requested by the Applicant.[3]

The above shortcomings constitute the premise for this appeal. To wit, the record of the Applicants' last interview with the Patent Office, memorialized by Supervisory Examiner Eric W. Stamber, attests to the impropriety of the repeated rejections and Applicants' frustration of the same.[4] In fact, the record of the aforementioned interview, attached as **Exhibit 4** to the Appeal Brief, so succinctly summarizes the issues before the board and the distinction between the invention and the cited prior art, that we highly recommend the board to review the interview summary prior to proceeding with considering the points discussed in this brief.

Accordingly, the Applicant respectfully continues to traverse the grounds of rejection for the following reasons:

(i) In absence of a cited reference for a claimed limitation, rejection based on "common knowledge" is not persuasive.[5]

(ii) The cited reference is non-analogous prior art and therefore is an improper reference.

(iii) The present invention as claimed is patentably distinct from the cited reference because there is no motivation to modify the reference to perform the claimed process and system of the present invention.

(i) Rejection based on "common knowledge" is improper without further support.

Since Capiel by itself "lacks explicit recitation of all the elements of the claimed invention,"[6] the Examiner contends that rejection under section 103(a) can be established by considering Capiel in light of "common knowledge" or "well known" prior art. Applicant in numerous instances has requested that the Examiner cite a reference or alternatively provide an affidavit in support of his rejection as required under MPEP §2144.03, and reasserts the same herein.

MPEP §2144.03 provides:

> "The rationale supporting an obviousness rejection may be based
> on common knowledge in the art or "well-known" prior art . . . [i]f the
> applicant traverses such an assertion the examiner should cite a reference

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[2] See Examiner Answer pages 8-26 and almost every page thereafter, Paper #33, pages 5-29 and Paper #27, pages 4-19, 22-31, and every basis of rejection in Papers #27 and #33.

[3] See Supplemental Brief page 5, and Applicant's response to Office Action mailed November 27, 2002, (page 8).

[4] See second and last paragraph of "Attachment to Interview Summary of Paper No. 28," signed by Supervisory Patent Examiner Eric W. Stamber, dated June 23, 2003, attached as Exhibit 4 to the Appeal Brief.

[5] MPEP §2144.03.

[6] See Examiner's Answer pages 8-26 and almost every other page, and Paper #33, pages 5-29.

in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."[7]

Particularly, on page 8 of the Applicants' response to the Office Action mailed November 27, 2002, the Applicant stated "[p]roviding supportive evidence is particularly important here because in every single page of the 30-page Office Action (and with respect to almost every claim), the Examiner has repeatedly relied on the "common knowledge" ... as the basis of rejection, without once offering any evidence to support this basis. Therefore, compliance with the provisions of MPEP §2144.03 and MPEP §2143 for *each instance* of rejection based on "common knowledge" is requested." (emphasis in original).

The examiner has failed to provide any support, whatsoever, for the allegation of common knowledge. Under the provisions of 37 CFR 1.130, 1.131. or 1.132, no new affidavits may be submitted at this point of the appeal process. As such, without supportive evidence, there is no sufficient basis for establishing a prima facie case of obviousness. Therefore, it is respectfully submitted that, at least for this reason alone, the arguments set forth in the Office Action regarding "common knowledge" should be stricken.

MPEP section 2144.03 further provides:

> (1) Reliance on "common knowledge" is appropriate only in "limited circumstances . . . however such rejections should be judiciously applied." (emphasis added)

In the present case, the entire basis for rejecting all pending claims in the application is based on common knowledge. It is respectfully submitted that this is not a judicious application of such ground of rejection, particularly as it has been applied to reject each and every pending claim.

> (2) "While "official notice" may be relied on, these circumstances should be *rare* when an application is under final rejection or action under 37 CFR 1.113." (emphasis added)

In the present case, the Examiner has used the common knowledge / official notice to force a ground of rejection in a final action without any support, documentary evidence, or affidavit.

> (3) "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art *are capable of instant and unquestionable demonstration as being well-known*." (emphasis added)

In the present case, the facts relating to the rejection based on "common knowledge" are directed

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[7] See also MPEP §2143.

to technological aspects of the invention (i.e., providing a unique identifier embedded in a website address to a server computer and recording the unique identifier in a log in association with an IP Address) that are not readily apparent to a person of ordinary skill in the art, and for that matter not instantly or unquestionably demonstrable as being well-known.

As noted by the court in In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute." (citing In re Knapp Monarch Co., 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). The facts that the Examiner has taken to be common knowledge are neither easy to demonstrate nor undisputed.

In In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) the court "reject[ed] the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice." The claimed invention is an improvement over the state of the art and therefore the subject of the present invention cannot be easily disputed.

> (4) "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of *esoteric technology* or specific knowledge of the prior art must *always* be supported by citation to some reference work recognized as standard in the pertinent art." In re Ahlert, 424 F.2d at 1091, 165 USPQ at 420-21. See also In re Grose, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) (emphasis added).

The area of technology claimed in the present invention (i.e., tracking website content accessed by a user) is not a type of technology that is commonly understandable. In fact, only a special and small group of people have specific knowledge of tracking technology. But no references have been found by the Examiner to date to show that any person skilled in the particular area of technology have disclosed, taught or implemented the claimed invention which improves upon the state of the art methods that require advanced registration or other intrusive methods.

> (5) "[W]hen the PTO seeks to rely upon a . . . theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory." In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973); In re Ahlert, 424 F.2d at 1091, 165 USPQ at 420-21. See also In re Grose, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979)

(6) It is *never* appropriate to rely *solely* on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 (emphasis added).

(7) "[T]he Board *cannot* simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board *must* point to some *concrete evidence* in the record in support of these findings." Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 (emphasis added).

(8) "[A]n assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. Zukro at 1385, 59 USPQ2d at 1697. See also In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002) (In reversing the Board's decision, the court stated " 'common knowledge and common sense' on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.")

Similar to the Zukro and Lee cases, here, the Examiner has relied on common knowledge to make a conclusory statement that the claimed invention is obvious. It is respectfully submitted that pursuant to the progeny of cases cited above such conclusory statement without any supportive evidence whatsoever is improper and insufficient to establish a primae facie case of obviousness.

(9) "Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See Lee, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection).

(10) "The examiner must provide *specific factual* findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." See Soli, 317 F.2d at 946, 37 USPQ at 801; Chevenard, 139 F.2d at 713, 60 USPQ at 241. That is "[t]he applicant should be presented with *the explicit basis* on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." (emphasis added)

Unfortunately, in the present case, the Examiner has failed to provide any specific factual finding or explicit basis in rejecting the pending claims based on common knowledge. More particularly, the rejections have been based on general statements made by the Examiner or references to one or two

specific lines in Capiel that bear no direct relationship to the present invention when read in context of the surrounding paragraphs. Because of this void of technical and scientific reasoning in the Examiner's answer, the Appalent has had difficulies with understanding the grounds of rejection, and has done its best to formulate a response to the vague and general arguments presented.

> (12) "If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding." See 37 CFR 1.104(d)(2).

The Examiner has failed to support his rejection based on common knowledge by an affidavit or declaration.

> (11) **"If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner *Must* Support the Finding With Adequate Evidence."** MPEP 2144.03 (emphasis added). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697.

<u>**The Examiner has failed to support his rejection based on common knowledge by any evidence whatsoever**</u>.

Referring to the above cases, any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion *cannot* be applied to finally reject claims. Furthermore, as noted by the court in <u>Ahlert</u>, it is *never* appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See <u>Zurko</u>, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421

(ii) The cited reference is non-analogous prior art.

It is respectfully submitted that Capiel is directed to non-analogous prior art. That is, Capiel does not function in the same manner as the claimed invention, nor does it produce the same or similar results.

The criteria for determining whether prior art is analogous are twofold. First, one must determine whether the art is from the same *field of endeavor*, regardless of the problem addressed. Second, if the reference is not within the field of the inventor's endeavor, one must determine whether the reference still is *reasonably pertinent to the "particular problem"* with which the inventor is involved.[8]

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[8] *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

Capiel "relates to the detection and monitoring of file formats which can be processed and displayed at an E-mail client."[9] As such, Capiel's field of endeavor relates to determining the "format" of the content of an email message. Conversely, the present invention is unrelated to content format. Instead, email is used as a tool to forward a link with an embedded identifier to an email recipient, regardless of the format. Therefore, it is respectfully submitted that Capiel is not within the field of endeavor of the present invention.

Referring to Capiel's Figures 1 and 2, attached as **Exhibit 5** to the Appeal Brief, and column 3, lines 5-55, email content may be produced in various formats such as in "plain text" or "HTML" format. It is more advantageous for a vendor to send promotional content in HTML format because, in addition to plain text, visual elements such as pictures or logos can be also included.

Unfortunately, however, some older email reader client software is <u>not</u> HTML enabled and can only read plain text emails. Therefore, it is useful for a vendor to determine if an email client is HTML enabled, so that the promotional material can be forwarded accordingly.

Capiel's solution is to survey the email client software in advance to determine if the email reader client can successfully read HTML content. The results of the survey are then collected into an email sensor database (132).

Referring to Fig. 1 of Capiel, to accomplish the above, the vendor system must communicate with an email sensor server (130) that in turn communicates with the email clients to determine system compatibility. In other words, according to the teachings of Capiel, an email sensor server (130) is <u>necessary</u> to act as an intermediary between the vendor system and the email clients in order to send the survey requests and to collect responses thereto.[10]

Referring to columns 5, 6, and 7 of Capiel, technically, a test request or email is forwarded to each email client. Each email includes an HTML "image tag" (i.e., 1 by 1 pixel gif image),[11] which is included in a specially identified executable part 316 of the email.[12] When an HTML enabled email client system opens the email, executable part 316 is automatically executed. As a result, the image tag passes to the

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[9] See Abstract.

[10] See col. 5, lns. 5-16 of Capiel.
[11] See col. 6, ln. 56 of Capiel.
[12] See Figure 3, attached as Exhibit 5 to the Appeal Brief.

email sensor server (130) the "type and version of the email client software."[13] This information basically identifies if the email client is an HTML enabled system.[14]

Thus, the system of Capiel is related to identifying an HTML enabled client system. That is, in Capiel the particular problem is to identify whether "format" of the email content sent to an email client is compatible with the email client software.

In contrast, the particular problem solved by the present invention is (1) providing an email recipient with access to a target web page, and (2) tracing the recipients activities on the target web page and subsequent web pages visited by the recipient, regardless of the formatting applied to the content of the email or the compatibility of the email content with the email client software.

The particular problems solved by the claimed invention are not even remotely addressed by Capiel. For the above reasons, the Applicant submits that the teachings of Capiel are neither within the same field of endeavor, nor reasonably pertinent to the particular problem solved by the present invention. Therefore, Capiel is non-analogous art and an improper prior art reference.

(iii) 103 Rejection: The present invention, as claimed, is patentably distinct from the cited reference and therefore is not obvious under Section 103(a).

MPEP §2143 provides:

> "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

It is respectfully submitted that none of the aforementioned three basic criteria are met. Applicant has previously provided arguments cogent to all three criteria in the Appeal Brief and the Supplemental Brief, the content of which is incorporated by reference herein. In this Reply Brief, arguments have been directed more specifically to new grounds of rejection cited in the Examiner's Answer.

In the Examiner's Answer, the Examiner has provided cites to portions of Capiel, in bold letters, as new grounds of rejection. The cited portions are:

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[13] See Col. 7, lns. 59-62 of Capiel.

(1) Capiel (col. 11, ll. 37-45; col. 11, ll. 50-67; and col. 12, ll. 1-50):

```
getClientIDCmd.CommandText='select    em_client_id    from    E-
Mail_clients where name=?'
Set    E-mailNameParm=getCliendIdCmd.CreateParameter    ('E-
mailparm',8,1)
GetClientIDCmd.Parameters.Append E-mailNameParm
getClientIDCmd(0)=broswerType. . . .
```

(2) Capiel (col. 1, ll. 43-67 and col. 2, ll. 1-24) discloses: "The invention in addition tracks the responses of the E-mail clients to further refine the 'visual media' group that responds positively to targeted advertisements with images. . . . the E-mail sensor server may . . . determine if a particular file format can be processed and displayed at the E-mail client. . . ."

(3) Capiel (col. 12, ll. 53-61; and col. 13, ll. 10-25) i.e., "'sensor server program' with parameters 'E-mail address' and 'unique mail code'. . . ." and "member id int. . . ."

(4) Capiel (col. 11, ll. 37-45; col. 11, ll. 50-67; and col. 12, ll. 1-50) which discloses:

```
getClientIDCmd.CommandText='select    em_client_id    from    E-
Mail_clients where name=?'
Set    E-mailNameParm=getCliendIdCmd.CreateParameter    ('E-
mailparm',8,1)
"GetClientIDCmd.Parameters.Append E-mailNameParm
getClientIDCmd(0)=broswerType. . . .
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(5) col. 12, ll. 53-61; col. 13, ll. 10-25, and col. 11, ll. 37-45; col. 11, ll. 50-67; and col. 12, ll. 1-50

Referring to Paper #33, the sections cited in bold in the Examiner Answer as duplicated above have been previously cited on pages 3-6 of Paper #33 and therefore do not constitute new grounds for rejection. Thus, apparently the Examiner's Answer is a full reiteration of all the prior papers filed (i.e., a copy and paste from all previous Office Actions) without substantially providing any new grounds of rejection or new arguments. It is respectfully submitted that such approach is not conducive to a timely resolution of matters on appeal. That is, if no new grounds of rejections are introduced, then the Examiner's Answer should not attempt to reopen prosecution! A proper response would have been to respond to arguments in the Supplemental Brief and allow this matter to proceed for a hearing before the Board.

Nevertheless, the Applicant has carefully reviewed the cited portions. Unfortunately, however, the cited portions are not supported with any additional or new arguments or reasoning by the Examiner. That is, both the Examiner's Answer and Paper #33 lack any additional arguments or reasoning beyond that included in the prior Office Actions as to how or why the cited portions are relevant and should be

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[14] See col. 5, lns. 5-16 of Capiel.

considered. Thus, any attempt on the part of Applicant to provide a response to the Examiner's Answer would be "speculative" because the Applicant would have to guess the Examiner's intent in providing the cited portions.

A review of the cited portions confirms our understanding of the teachings of Capiel in that the E-mail sensor of Capiel functions to "determine if a particular <u>file format</u> can be processed and displayed at the E-mail client." (emphasis added) (See paragraph 4 above).

Furthermore, the 4 lines of code repeated in paragraphs 1 and 4 above are from an exemplary "Visual Basic Script" that runs on the E-mail Sensor server 130 of Capiel. Referring to column 11, lines 5-10 of Capiel, the script's functionality is illustrated in FIG. 7 of Capiel. FIG. 7 is related to a method of determining an email client software type and associating the determined type with a user's email address (see steps 610 to 618). The Applicant, unfortunately, due to the lack of any supportive arguments in the Examiner's Answer cannot speculate how the process disclosed in FIG. 7 teaches or suggests the claimed invention.

The Applicant has further reviewed the remaining cited portions in conjunction with all the other portions cited in the Examiner Answer. Unfortunately, the Applicant is unable to formulate any intelligible counter arguments, as it remains vague to the Applicant how the newly cited portions add anything at all to the submitted arguments in the previous Office Actions.

For example, referring to claim 75, examined and rejected by the Examiner, the Applicant invites the Examiner to explain how any of the cited portions of Capiel above teach or suggest any of the following elements that particularly recite the relationship between the URL and IP Address stored in the log to track the web pages accessed by the user:

> (1) "embedding a unique identifier within a uniform resource locator (URL) . . . the URL identifying one or more *web pages*;"

> (2) "including the URL in form of a link in an email . . . , wherein *selecting the link provides the email recipient with access to the one or more web pages*;"

> (3) "providing the unique identifier to the server computer by way of a *request* submitted by the client computer *to access said one or more web pages*, . . . wherein the *request* includes the URL in which the unique identifier is embedded;"

> (3) "automatically storing the *unique identifier in association* with the *IP address* of the client computer in a log file of the server

computer; and"

> (4) "automatically storing *access information about the one or more web pages visited by the email recipient in association with the IP address of the client computer in the log file of the server computer.*"
> (emphasis added)

Furthermore, there can be no motivation to modify Capiel to perform the claimed process and system of the present invention because Capiel uses a different method, configuration, and system structure, altogether to determine if a particular file format can be processed by an email client. Some of the differences are enumerated below.

(1) Capiel includes an image tag in a particular executable portion of an email. This is not equivalent to embedding a unique identifier into a website address, as claimed in the present invention.

(2) In Capiel, the image tag is automatically executed once the email is opened. This is not equivalent to a user actively selecting a web site address with the embedded unique identifier, as claimed in the present invention.

(3) Execution of the image tag of Capiel simply forwards certain file format information to the email sensor server. In the present invention, selecting the web site address provides the user with access to one or more web sites.

(4) File format information provided to the email sensor server only indicates if an email client is HTML enabled. The image tag does not and cannot provide any information about which web sites were visited by a user who selected a link in the email, as claimed. Further, the image tag cannot cause information about the visited web sites to be automatically recorded in the web log for tracking user behavior.

(5) In the system of Capiel, the email sensor server "serves as a middleman information collection point between the vendor systems . . . and the E-mail clients."[15] That is, the email sensor server is an integral part of the system of Capiel, without which the system of Capiel would fail. The present invention does not require a middleman server for collecting the identifying information.

(6) The email sensor server of Capiel collects information about whether an email client machine

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[15] See Col. 3, lns. 15-21 of Capiel.

includes HTML enabled email software.[16] Therefore, the only data that the system of Capiel can collect is data that resides in the client side. In contrast, the claimed invention causes a unique identifier to be automatically stored into a log file of the web server *in association* with other information that defines consumer activity (see claim 2). According, the present invention does <u>not</u> require access to the client system. Instead, information is retrieved from the server side.

(7) The image tag of Capiel CANNOT provide (nor can it be modified to provide) the email clients with access to other web sites, and the system of Capiel CANNOT function (nor can it be modified to function) without an email sensor server transmitting, monitoring and collecting requests and information transmitted between the email clients, the email server and the vendor systems. In contrast, according to the claimed invention, connection between an email client and a target web page is seamlessly established, at the same time as the unique identifier is transmitted to the web hosting server and recorded in the web log without the need for implementing an intermediary "middleman" email sensor server.

(8) Capiel provides a solution to an old problem dealing with primitive email client software that is limited to reading text messages only. (Such email software is most likely not in use any longer.) In contrast, the present invention claims a method for addressing the most current trends for successfully, accurately, and efficiently collecting information about web page viewing activities of a user without intrusive requests for user registration.

Based on the above and because Capiel is directed to solving a completely different problem using a completely different system, the Applicant respectfully submits that there is no likelihood that the system of Capiel can be successfully modified to perform the claimed process of the present invention. Nor could it be reasonably expected from a person of ordinary skill in the art to modify the system of Capiel to achieve the same results.

Moreover, it has been long held that while the suggestion to combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge.[17]

The Examiner has not been able to suggest a reasonable motivation for modifying the teachings of Capiel in the direction of the present invention. Even if one were to modify Capiel, there would be no

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[16] See col. 12, lns. 63-65 of Capiel.
[17] *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998).

reasonable expectation of success because embedding an image tag with a unique identifier does not allow a user to access any web pages, and alternatively if in some magical way a user were to access a web page using the system of Capiel, then the unique identifier in the image tag would not have been recorded in the host server's web log.

Without the benefit of the Applicant's disclosure, there would have been no incentive or reason for one of ordinary skill in the art to contemplate modifying the system of Capiel in any way based on common knowledge. The combination/modification proposed by the Examiner simply is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner is impermissible hindsight reconstruction given the benefit of the Applicant's disclosure.

Since no reasonable motivation has been cited to suggest modifying Capiel in the direction of the claimed invention, a prima facie case of obviousness has not been established.

The Applicant respectfully asks the Board to review the following chart as it is helpful to understanding the distinction between the claimed invention and Capiel. The Applicant has selected Claim 75 as the more detailed claim to illustrated said differences with more specificity:

Claim 75	Capiel
75. A computer-implemented method for electronically tracking web pages visited by an email recipient without requiring advanced registration, the method comprising:	- Capiel is directed to a method of determining if an email browser can read HTML formatted messages (Abstract). That is, Capiel does not suggest a method for tracking web pages visited by an email recipient.
embedding a unique identifier within a uniform resource locator (URL), the unique identifier uniquely identifying an email recipient, the URL identifying one or more web pages;	- While the image tag of Capiel includes an identifier, the identifier identifies an email message, not an email recipient as claimed (col. 7, lns. 49-50). -Further, the image tag of Capiel does not include a URL that identifies one or more web pages, contrary to the Examiner's assertion.
including the URL in form of a link in an email sent to the email recipient, wherein selecting the link provides the email recipient with access to the one or more web pages;	- First, the image tag of Capiel does not include a URL that identifies one or more web pages provided through the email sensor server for access by the email recipient. - Since the image tag of Capiel does not include a URL that identifies one or more web pages, then no web pages can be accessed by way of the email sensor of Capiel by an email recipient that selects the link including the URL. - Second, there is no motivation for modifying Capiel in

	that direction, because the URL in the image tag is implemented to call a program (sensor server program) for execution on the email sensor server rather than to provide access to one or more web pages. (col. 3, lns. 38-41).
	- In fact, modification of the sensor server in that direction would destroy the utility of the Capiel's system. Execution of the "sensor server program" is only possible since the image tag is implemented to call the "sensor server program" stored on the email sensor server (col. 3, lns. 35-40). Thus, implementing the image tag to instead provide access to one or more websites would make impossible execution of the sensor server program and therefore disable the Capiel's system. - Regardless, even if such modification is possible, the email sensor server of Capiel is not a content server and therefore no web pages would be available for access by the email recipient.
establishing a connection between a server computer and a client computer used by the email recipient to receive the email, in response to the email recipient selecting the link, wherein the server computer provides access to the one or more web pages identified by the URL;	- As discussed, since Capiel's image tag does not include a URL identifying one or more websites and Capiel's email sensor server cannot provide access to one or more websites, it follows that Capiel cannot suggest a user selecting the URL embedded in the link to access one or more web pages.
providing the unique identifier to the server computer by way of a request submitted by the client computer to access said one or more web pages, independent from any profile information previously stored on the client computer, wherein the request includes the URL in which the unique identifier is embedded;	- In Capiel, a URL comprising a user id is not sent from an email client (i.e., client computer) to the email sensor server (i.e., server computer) after a user selects a link in an email he has received. That is: 1. While Capiel teaches including hyperlinks in an email, in the system of Capiel, instead of a <u>hyper link</u>, an <u>image tag</u> performs the function of sending a "unique email code" to the sensor server. As such, Capiel teaches away from using a hyper link to perform the claimed function (i.e., access one or more websites). (col. 3, lns. 35-41 and col. 7, lns. 34-40) 2. Unlike the hyper link that requires a user to actively select it by clicking it, the image tag does not require active selection by the user, but is automatically executed, only if the email reader is HTML enabled. (col. 3, lns. 35-41 and col. 7, lns. 34-40) 3. The image, unlike the claimed hyperlink does not provide access to content displayable on the client computer. Particularly, the image tag includes the following URL format and parameters:

	src="http://sensorserver.domain.com / sensorrserverprogram / catid=unique email code . . ." (col. 7, lns. 34-40). - The first parameter (i.e., "sensorserver.domain.com") identifies the location of the email sensor server to which the URL is submitted (col. 3, lns. 35-41). - The second parameter (i.e., "sensor server program") is an executable file stored and executed on the sensor server in response to the sensor server receiving the URL (col. 3, lns. 35-41). - And, the third parameter (i.e., "unique mail code") identifies an email client when the image tag is automatically executed at the email client. (col. 3, lns. 35-41). - Neither of the above parameters perform the two claimed functions of providing access to one or more webpages in combination with a user identifier, as claimed.
parsing the URL in the request to retrieve the unique identifier embedded in the URL;	- Capiel fails to teach or suggest parsing the URL in the request to retrieve the unique identifier embedded in the URL;
identifying the email recipient based on the retrieved unique identifier;	Capiel fails to teach or suggest identifying the email recipient based on the retrieved unique identifier;
automatically storing the unique identifier in association with the IP address of the client computer in a log file of the server computer	Capiel fails to teach or suggest recording an association between the unique identifier and the IP address of the client computer.

1. The Rejection of Claims 1, 22, 45, 52, 75, 78, and 81

The Applicant incorporates by reference herein the arguments provided in the Appeal Brief under this section, pointing out claim elements not suggested by Capiel.

2. The Rejection of Claims 2, 10, 23, 46, 76, 79, and 82

The Applicant incorporates by reference herein the arguments provided in the Appeal Brief under this section, pointing out claim elements not suggested by Capiel.

3. The Rejection of Claims 3, 4, 24, 25, 47, 48, and 51

The Applicant incorporates by reference herein the arguments provided in the Appeal Brief under this section, pointing out claim elements not suggested by Capiel.

4. The Rejection of Claims 5, 26, and 50

The Applicant incorporates by reference herein the arguments provided in the Appeal Brief under this section, pointing out claim elements not suggested by Capiel.

5. The Rejection of Claims 6-14, 27-35, and 80

The Applicant incorporates by reference herein the arguments provided in the Appeal Brief under this section, pointing out claim elements not suggested by Capiel.

6. The Rejection of Claims 15-21, 36-44, 49 and 77

The Applicant incorporates by reference herein the arguments provided in the Appeal Brief under this section, pointing out claim elements not suggested by Capiel.

For the reasons discussed above with respect to independent claims 1, 22, 45, and 52, 75, 78, and 81, since obviousness may not be established by hindsight reconstruction or conjecture, and because Capiel fails to teach the claimed elements, it is respectfully submitted that the rejection of all claims under 35 U.S.C. §103 is improper and should be reversed.

CONCLUSION

The prior art of record, considered singly or collectively, fails to disclose or in any way suggest Applicant's claimed invention. Accordingly, appealed claims 1-52 and 75-82 should be allowed.

This Reply Brief is submitted herewith along with an Appendix of the Appealed Claims. The requisite fee for filing the brief has been already submitted.

Please feel free to forward any questions and comments to the undersigned, at the phone number (310) 789 2100.

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Respectfully submitted,

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CLAIMS APPENDIX

Claims remain unchanged as filed in the Appeal Brief and are included herein once more.

1.   A method for electronically identifying a consumer without requiring consumer registration, the method comprising:

embedding a unique identifier within a web site address, the unique identifier uniquely identifying an email recipient;

including the web site address in an electronic mail message sent to the email recipient, wherein the web site address provides the email recipient with access to one or more web sites;

establishing a connection between a client computer used by the email recipient to receive the email and a server computer providing access to the one or more web sites, in response to the email recipient selecting a reference to the web site address included in the electronic mail message;

providing the unique identifier to the server computer by way of sending the web site address to the server computer in a request submitted by the client computer to access said one or more web sites, independent from any consumer profile information previously stored on the client computer;

parsing the web site address in the request, to retrieve the unique identifier embedded in the web site address;

identifying the email recipient based on the retrieved unique identifier; and

tracking the email recipient's movement within the one or more web sites by associating the unique identifier with information that defines consumer activity within said one or more web sites.

2.   The method of Claim 1, wherein the act of tracking the email recipient's movement within said one or more web sites comprises:

storing in at least one log file the unique identifier in association with the information that defines consumer activity; and

extracting the information that defines consumer activity based on said association to track consumer movement.

3.   The method of Claim 1, wherein the act of associating the unique identifier with information that defines consumer activity comprises:

identifying an IP address of the client computer, wherein the IP address is automatically logged in correspondence with the information that defines consumer activity; and

associating the unique identifier with the IP address such that the information that defines consumer activity can be extracted based on the association between the IP address and the unique identifier.

4.   The method of Claim 1, wherein the act of associating the unique identifier with information that defines consumer activity comprises:

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identifying connection specific information related to the established connection between the client computer and the one or more web sites, wherein the connection specific information is automatically logged in correspondence with the information that defines consumer activity; and

associating the unique identifier with of the connection specific information such that information that defines consumer activity can be extracted based on the association between of the connection specific information and the unique identifier.

5. The method according to Claim 1, wherein the unique identifier identifies a consumer's electronic mail address.

6. The method according to Claim 1, wherein the one or more web sites include a plurality of links to other web pages located at a plurality of web servers.

7. The method according to Claim 6, wherein the plurality of links to other web pages includes a link to a web page from where the consumer purchases merchandise.

8. The method according to Claim 6, wherein the plurality of links to other web pages includes a link to a web page from where the consumer electronically views images of merchandise.

9. The method according to Claim 6, wherein the plurality of links to other web pages includes a link to a web page from where the consumer electronically contacts a seller.

10. The method according to Claim 1, wherein information about the consumer's movement within the one or more web sites is stored in a log file.

11. The method according to Claim 10, wherein the log file includes the addresses of the one or more web sites.

12. The method of Claim 10, wherein the log file includes information regarding number of times the consumer accesses a particular web site.

13. The method of Claim 10, wherein the log file includes information regarding any purchase the consumer makes while visiting the one or more web site.

14. The method according to Claim 10, wherein the log file includes duration of the consumer's visit to a particular web site.

15.   The method according to Claim 10, further comprising:

developing a consumer master database based upon the log file;

querying the master database; and

determining consumer preferences.

16.   The method according to Claim 15, wherein the master database includes a plurality of segments including an email look up segment that includes a listing of a plurality of consumer electronic mail addresses with corresponding unique identifiers.

17.   The method according to Claim 15, wherein the master database includes a consumer information segment that contains consumer related information.

18.   The method according to Claim 15, wherein the master database includes a promotional material segment that includes information regarding promotional materials.

19.   The method according to Claim 15, wherein the master database includes a purchasing segment that includes information regarding purchases made by the consumers.

20.   The method according to Claim 15, wherein the master database includes a URL segment that includes a plurality of URLs with corresponding keywords and plurality of keycodes associated with the keywords.

21.   The method according to Claim 15, wherein the master database includes a credit card segment that includes consumer credit card number, date and amount of purchase by consumer.

22.   Computer executable process stored in a computer readable medium for identifying a consumer without requiring consumer registration, the process comprising:

embedding a unique identifier within a web site address, the unique identifier uniquely identifying a consumer;

establishing a connection between the consumer's computer and a server computer providing access to one or more web sites, in response to a consumer selecting a reference to the web site address forwarded by way of electronic mail;

providing the unique identifier to the server computer by way of sending the website address to the server computer to access the one or more web sites, independent from any consumer profile information previously stored on the client computer;

parsing the web site address to retrieve the unique identifier embedded in the web site address; and

tracking the consumer's movement within the one or more web sites by associating the

unique identifier with information that defines consumer activity within said one or more web sites.

23.   The computer executable process of Claim 22, wherein the act of tracking consumer movement within said one or more web sites comprises:

storing in a log file the unique identifier in association with the information that defines consumer activity within said one or more web sites;

searching the log file for the unique identifier; and

extracting the information that defines consumer activity based on its association with the unique identifier to track consumer movement.

24.   The computer executable process of Claim 22, wherein the act of associating the unique identifier with information that defines consumer activity comprises:

identifying an IP address used for establishing the connection between the consumer's computer and the one or more web sites, wherein the IP address is automatically logged in correspondence with the information that defines consumer activity; and

associating the unique identifier with the IP address such that the information that defines consumer activity can be extracted based on the association between the IP address and the unique identifier.

25.   The computer executable process of Claim 22, wherein the act of associating the unique identifier with information that define consumer activity comprises:

identifying connection specific information related to the established connection between the consumer's computer and the one or more web sites, wherein the connection specific information is automatically logged in correspondence with the information that defines consumer activity; and

associating the unique identifier with the connection specific information such that data that defines consumer activity can be extracted based on the association between the IP address and the unique identifier.

26.   Computer executable process steps according to Claim 22, wherein the unique identifier identifies a consumer's electronic mail address.

27.   (Amended) Computer executable process steps according to Claim 22, wherein the one or more web sites include a plurality of links to other web pages located at a plurality of web servers.

28.   Computer executable process steps according to Claim 27, wherein the plurality of links to other web pages located at a plurality of web servers includes a link to a web page from where the consumer can purchase merchandise.

29.   Computer executable process steps according to Claim 27, wherein the plurality of links to other web pages includes a link to a web page from where the consumer can electronically view images of merchandise.

30.   Computer executable process steps according to Claim 27, wherein the plurality of links to other web pages includes a link to a web page from where the consumer may electronically contact a seller.

31.   Computer executable process steps according to Claim to 22, wherein information about the consumer's movement within the one or more web sites is stored in a log file.

32.   Computer executable process steps according to Claim according to 31, wherein the log file includes the addresses of the one or more web sites.

33.   Computer executable process steps according to Claim 31, wherein the log file includes information regarding number of times the consumer accesses a particular web site.

34.   Computer executable process steps according to Claim 31, wherein the log file includes information regarding any purchase the consumer makes while visiting the one or more web site.

35.   Computer executable process steps according to Claim 31, wherein the log file includes the duration of the consumer's visit to a particular web site.

36.   Computer executable process steps according to Claim 31, further comprising:

        developing a consumer master database based upon the log file;

        querying the master database; and

        determining consumer preferences.

37.   Computer executable process steps according to Claim 36, wherein the master database includes a plurality of segments including an email look up segment that includes a listing of a plurality of consumer electronic mail addresses with corresponding unique identifiers.

38.   Computer executable process steps according to Claim 36, wherein the master database includes a consumer information segment that contains consumer related information.

39.   Computer executable process steps according to Claim 36, wherein the master

database includes a promotional material segment that includes information regarding promotional materials.

40. Computer executable process steps according to Claim 36, wherein the master database includes a purchasing segment that includes information regarding purchases made by the consumers.

41. Computer executable process steps according to Claim 36, wherein the master database includes a URL segment for storing plurality of keywords associated with plurality of URLs, and the plurality of key codes associated with plurality of keywords.

42. Computer executable process steps according to Claim 36, wherein the master database includes a credit card segment that includes consumer credit card number, date and amount of purchase by consumer.

43. The method of Claim 1, wherein the unique identifier is a consumer's credit card information.

44. The computer executable process of Claim 22, wherein the unique identifier is a consumer's credit card information.

45. A method for electronically identifying a consumer without requiring consumer registration, the method comprising:

receiving a consumer request to access one or more web sites implemented on at least one server computer, wherein the consumer request is submitted by way of a client computer and the request includes a web site address, sent to the consumer in an electronic mail message, with a unique identifier embedded in the web site address for uniquely identifying the particular consumer;

parsing the web site address to find the unique identifier; and

logging the unique identifier in one or more log files in association with information that defines consumer activity within said one or more web sites, independent from any consumer profile information previously stored on the client computer by any servers.

46. The method of Claim 45, further comprising:

extracting the information that defines consumer activity based on its association with the unique identifier to track consumer movement.

47. The method of Claim 45, wherein the consumer request is received through a connection established between the consumer's computer and the one or more web sites, the method further comprising:

identifying at least one of connection and environment specific information related to the established connection between the consumer's computer and the one or more web sites, wherein at least one of the connection and environment specific information is automatically logged in correspondence with the information that defines consumer activity; and

associating the unique identifier with at least one of the connection and environment specific information such that information that defines consumer activity can be extracted based on the association between at least one of the connection and environment specific information and the unique identifier.

48.   The method of Claim 47, wherein at least one of the connection and environment specific information relates to IP address of the consumer's computer.

49.   The method of Claim 47, wherein the unique identifier relates to credit card information of the consumer.

50.   The method of Claim 47, wherein the unique identifier relates to electronic mail address of the consumer.

51.   The method of Claim 47, wherein at least one of the connection and environment specific information relates to an operating system executing on the consumer's computer.

52.   A unique identifier embedded in a URL provided to a consumer by way electronic mail, such that when the consumer selects the URL a connection is established between a consumer computer having a first IP address and a web server providing access to one or more web sites, wherein the web server receives the URL via said established connection independent from any consumer profile information previously stored on the client computer, wherein the web server parses the URL for the unique identifier, and wherein the IP address is recorded in a log file in association with the unique identifier.

75.   A computer-implemented method for electronically tracking web pages visited by an email recipient without requiring advanced registration, the method comprising:

embedding a unique identifier within a uniform resource locator (URL), the unique identifier uniquely identifying an email recipient, the URL identifying one or more web pages;

including the URL in form of a link in an email sent to the email recipient, wherein selecting the link provides the email recipient with access to the one or more web pages;

establishing a connection between a server computer and a client computer used by the email recipient to receive the email, in response to the email recipient selecting the link, wherein the server computer provides access to the one or more web pages identified by the URL;

providing the unique identifier to the server computer by way of a request submitted by the client computer to access said one or more web pages, independent from any profile information previously stored on the client computer, wherein the request includes the URL in which the

unique identifier is embedded;

parsing the URL in the request to retrieve the unique identifier embedded in the URL;

identifying the email recipient based on the retrieved unique identifier;

automatically storing the unique identifier in association with the IP address of the client computer in a log file of the server computer; and

automatically storing access information about the one or more web pages visited by the email recipient in association with the IP address of the client computer in the log file of the server computer.

76.   The computer-implemented method of Claim 75, further comprising:

extracting the access information for a particular email recipient by cross-referencing the IP address of the client computer used by the particular email recipient with respective access information and unique identifier stored in the log file in association with the IP address.

77.   The computer-implemented method of Claim 75, wherein the access information comprises at least one of: an address of a web page visited by the email recipient, duration of the visit, and purchase information during of the visit.

78.   A computer system for electronically tracking web pages visited by an email recipient without requiring advanced registration, the system comprising:

means for embedding a unique identifier within a uniform resource locator (URL), the unique identifier uniquely identifying an email recipient, the URL identifying one or more web pages;

means for including the URL in form of a link in an email sent to the email recipient, wherein selecting the link provides the email recipient with access to the one or more web pages;

means for establishing a connection between a server computer and a client computer used by the email recipient to receive the email, in response to the email recipient selecting the link, wherein the server computer provides access to the one or more web pages identified by the URL;

means for providing the unique identifier to the server computer by way of a request submitted by the client computer to access said one or more web pages, independent from any profile information previously stored on the client computer, wherein the request includes the URL in which the unique identifier is embedded;

means for parsing the URL in the request to retrieve the unique identifier embedded in the URL;

means for identifying the email recipient based on the retrieved unique identifier;

means for automatically storing the unique identifier in association with the IP address of the client computer in a log file of the server computer; and

means for automatically storing access information about the one or more web pages visited by the email recipient in association with the IP address of the client computer in the log file of the server computer.

79.   The computer system of Claim 78, further comprising:

means for extracting the access information for a particular email recipient by cross-referencing the IP address of the client computer used by the particular email recipient with respective access information and unique identifier stored in the log file in association with the IP address.
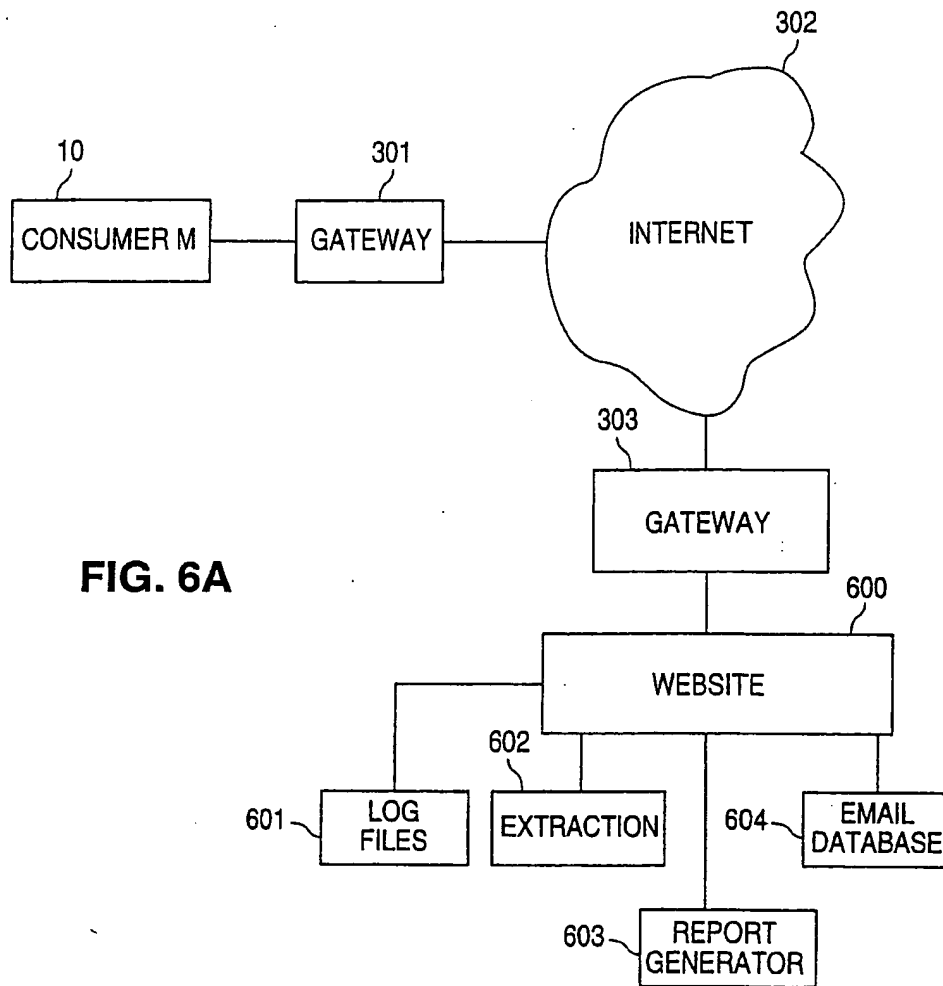

80.   The computer system of Claim 78, wherein the access information comprises at least one of: an address of a web page visited by the email recipient, duration of the visit, and purchase information during of the visit.

81.   A computer-readable medium comprising a computer-executable process stored for electronically tracking web pages visited by an email recipient without requiring advanced registration, the computer-executable process comprising:

embedding a unique identifier within a uniform resource locator (URL), the unique identifier uniquely identifying an email recipient, the URL identifying one or more web pages;

including the URL in form of a link in an email sent to the email recipient, wherein selecting the link provides the email recipient with access to the one or more web pages;

establishing a connection between a server computer and a client computer used by the email recipient to receive the email, in response to the email recipient selecting the link, wherein the server computer provides access to the one or more web pages identified by the URL;

providing the unique identifier to the server computer by way of a request submitted by the client computer to access said one or more web pages, independent from any profile information previously stored on the client computer, wherein the request includes the URL in which the unique identifier is embedded;

parsing the URL in the request to retrieve the unique identifier embedded in the URL;

identifying the email recipient based on the retrieved unique identifier;

automatically storing the unique identifier in association with the IP address of the client computer in a log file of the server computer; and

automatically storing access information about the one or more web pages visited by the email recipient in association with the IP address of the client computer in the log file of the server computer.

82.   The computer-readable medium of claim 81, wherein the computer-executable process further comprises:

extracting the access information for a particular email recipient by cross-referencing the IP address of the client computer used by the particular email recipient with respective access information and unique identifier stored in the log file in association with the IP address,

wherein the access information comprises at least one of: an address of a web page visited by the email recipient, duration of the visit, and purchase information during of the visit.

EVIDENCE APPENDIX

1.   Exhibit 1: Figs. 6B, 6C are attached to the Appeal Brief

2.   Exhibit 2: Fig. 7A is attached to the Appeal Brief

3.   Exhibit 3: <u>Declaration of Bruce Eisen</u>, CEO of UserTrends, Inc., and <u>Declaration of James Fedolfi</u>, VP of eContacts, Inc., attached as to the Appeal Brief

4.   Exhibit 4: The record of the Applicants' interview with the Patent Office, memorialized by Supervisory Examiner Eric W. Stamber succinctly summarizes the issues before the board and the distinction between the invention and the cited prior art.

5.   Exhibit 5: Capiel's Figures 1 and 2 are attached to the Appeal Brief.

Exhibit content remains unchanged as filed in the Appeal Brief.

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| CONSUMER M | — | GATEWAY | — | INTERNET |

303

| GATEWAY |

FIG. 6A

600

| WEBSITE |

| 601 — | LOG FILES | | 602 — EXTRACTION | | 604 — | EMAIL DATABASE |

| 603 — | REPORT GENERATOR |

To: CONSUMERM@dgo.com — 604
From: RETAIL STORE — 605
Re: Promotional material

http://www.mystore.com/?XXXX — 606

FIG. 6B

607

606

11

File Edit View Go Bookmarks Options Directory Window Help

Back Forward Home Edit Reload Images Open Print Find Stop

Location: HTTP://www.MYSTORE.com/PXXXX

611

PRODUCTS

PURCHASE

CONTACT

608

609

610

FIG. 6C
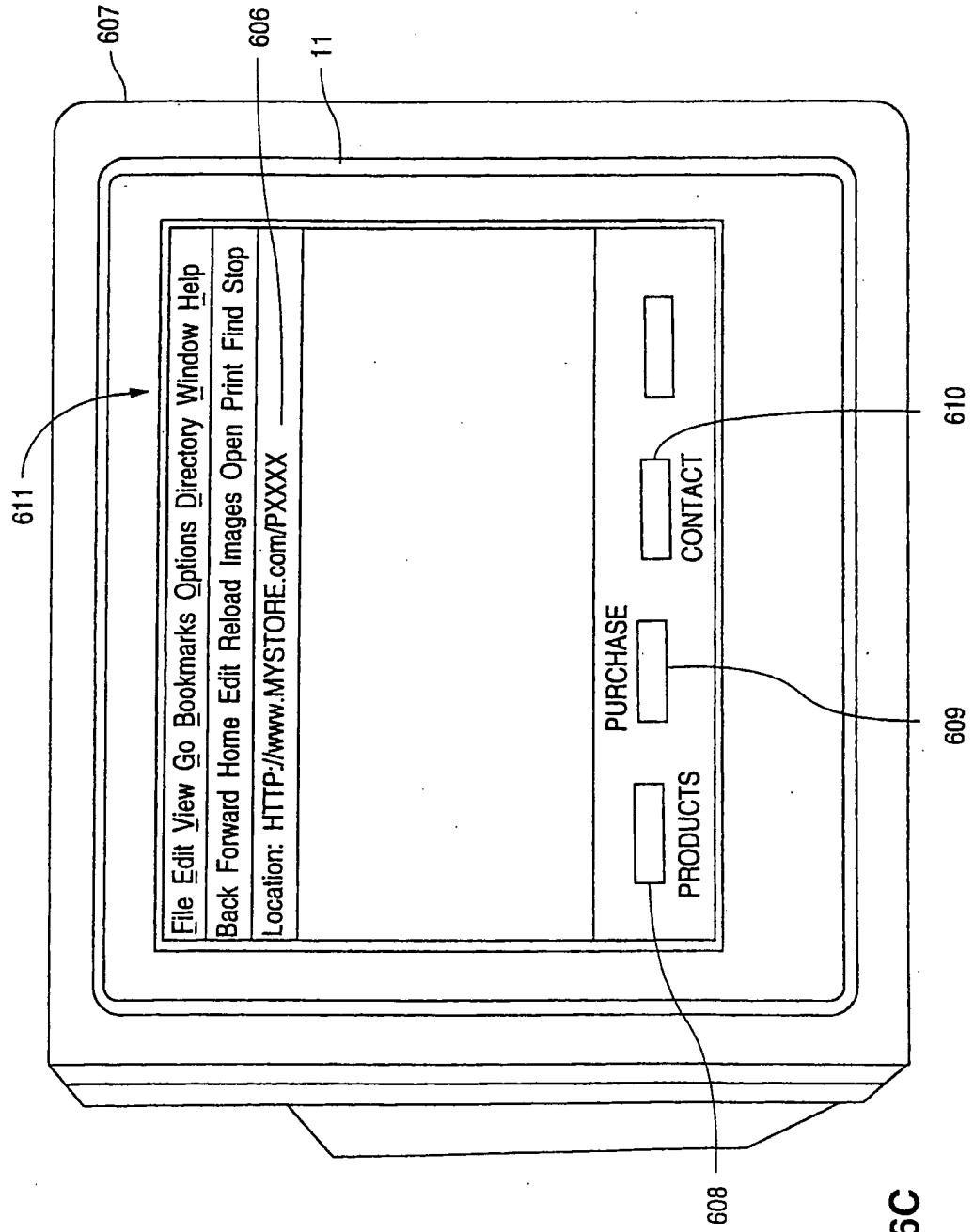
FIG. 7A

IP NUMBER 701	DATE AND TIME 702	URL 703
202.247.132.194 - -	[02/Jun/1999:16:13:02 -0700]	"GET/email/index.html?UTID=XXXX&UTPN=5678&UTSN=9876 HTTP/1.1" 200 3503
207.247.132.194 - -	[02/Jun/1999:16:13:02 -0700]	"GET/email/img/quick.GIF HTTP/1.1" 200 2411
207.247.132.194 - -	[02/Jun/1999:16:13:03 -0700]	"GET/email/img/go.gif HTTP/1.1" 200 240
207.247.132.194 - -	[02/Jun/1999:16:13:03 -0700]	"GET/email/img/order.GIF HTTP/1.1" 200 3364
207.247.132.194 - -	[02/Jun/1999:16:13:03 -0700]	"GET/email/img/line.GIF HTTP/1.1" 200 79
207.247.132.194 - -	[02/Jun/1999:16:13:04 -0700]	"GET/email/img/logo.GIF HTTP/1.1" 200 2628
207.247.132.194 - -	[02/Jun/1999:16:13:05 -0700]	"GET/email/img/products.GIF HTTP/1.1" 200 93286
207.247.132.194 - -	[02/Jun/1999:16:13:09 -0700]	"GET/email/bottom.htm HTTP/1.1" 200 910
207.247.132.194 - -	[02/Jun/1999:16:13:09 -0700]	"GET/email/img/bg.GIF HTTP/1.1" 200 99
207.247.132.194 - -	[02/Jun/1999:16:13:09 -0700]	"GET/email/img/email.GIF HTTP/1.1" 200 3227
207.247.132.194 - -	[02/Jun/1999:16:13:09 -0700]	"GET/email/img/link_wine.gif HTTP/1.1" 200 2260
207.247.132.194 - -	[02/Jun/1999:16:13:09 -0700]	"GET/email/img/link_computer.gif HTTP/1.1" 200 2159
207.247.132.194 - -	[02/Jun/1999:16:13:10 -0700]	"GET/email/img/link_sports.gif HTTP/1.1" 200 2084
207.247.132.194 - -	[02/Jun/1999:16:13:10 -0700]	"GET/email/img/link_fashion.gif HTTP/1.1" 200 2067
207.247.132.194 - -	[02/Jun/1999:16:13:10 -0700]	"GET/email/img/link_art.gif HTTP/1.1" 200 2082
207.247.132.194 - -	[02/Jun/1999:16:13:10 -0700]	"GET/email/img/link_furniture.gif HTTP/1.1" 200 2171
207.247.132.194 - -	[02/Jun/1999:16:13:10 -0700]	"GET/email/img/links.gif HTTP/1.1" 200 674
207.247.132.194 - -	[02/Jun/1999:16:13:10 -0700]	"GET/email/img/h_computers.GIF HTTP/1.1" 200 7555
207.247.132.194 - -	[02/Jun/1999:16:13:13 -0700]	"GET /email/EmblazeVideoPro/computerv_toshiba_notbook.htm HTTP/1.1" 200 1971
207.247.132.194 - -	[02/Jun/1999:16:13:14 -0700]	"GET/email/img/movieframe.gif HTTP/1.1" 200 482

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Bruce Eisen et al.
Assignee:	User Trends, Inc.
Title:	Electronically Distributing Promotional And Advertising Material Based Upon Consumer Internet Usage

Serial No.:	09/379,167	Filing Date:	08/23/99
Examiner:	John L. Young	Group Art Unit:	2162
Docket No.:	M-7729 US		

Assistant Commissioner of Patents
Washington, D.C. 20231

DECLARATION OF BRUCE EISEN

I, <u>Bruce Eisen</u>, the undersigned declare as follows:

1.   I am the [your title] of UserTrends corporation. UserTrends is a privately held company headquartered in Los Angeles, California, which has developed proprietary e-mail marketing personalization solutions for both traditional and online retailers.

2.   I have been in the email marketing industry for approximately ???? years. In my capacity as the [your title] of UserTrends, I make decisions involving [. . . . .]. Based on my background and experience in the industry, the scope of my duties as the [your title] of UserTrends, my personal experience with UserTrends technology, and my knowledge of other technologies in the email marketing industry, I provide you the following professional opinion.

3.   UserTrends data collection tools help companies learn about and precisely target individual customer interests. These solutions enable marketers to generate higher response rates to promotions, save on marketing costs, and increase sales and profits---all, while building a loyal customer base.

4.   UserTrends' technology is different from cookie profiling and other email consumer profiling technologies for the following reasons: (1) UserTrends' technology accurately profiles a particular individual's interests and preferences by focusing on a known identifier associated with that particular individual, rather than using unanimous identifying means (i.e., a cookie) typically associated with a computer used by the individual, (2) UserTrends' technology does not require storage of a unique identifier on the client computer at any time and therefore does not require use of a certain "cookie handling feature" provided in a browsing software, (3) UserTrends' technology does not require authorized access to the client computer to retrieve information in a cookie file, (4) because of the above advantages implementation of UserTrends' technology requires substantially less resources and no or minimal customization and is substantially less expensive, and (5) UserTrends' technology does not burden the targeted audience to go through a lengthy or inconvenient registration process.

5.   Competing electronic consumer profiling technologies generally capture individual data via an unfriendly registration process or by requiring a visitor logging in to the site or making a purchase. The e-marketing industry has generally used such data for mass direct marketing campaigns. In the case of data collected through a lengthy registration process, which only reveals a consumer's interest at a *particular moment* in time, aggregate profiling is usually necessary to determine what promotions to send the consumer.

6.   Various competing profiling methods and their disadvantages when compared to UserTrends' technology are provided below:

> Purchase Profiling – While purchase profiling is an accurate way of determining one interest of a customer, it isn't able to relate the customer's interests with other products they looked at but did not purchase. UserTrends' technology doesn't require a purchase or input of sensitive financial information to collect behavior data.

> Registration Profiling – This requires individuals to take the time to fill out a long survey to provide marketers with some data regarding their particular interests. Unfortunately, the accuracy and reliability of such collected data are often questionable. These surveys can also often fail to weigh customer interests and only represent interests at one remote instance – although interests change, registrations remain the same. UserTrends'

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technology does not require a burdensome registration and allows updating users' interest data based on each individual user's activities on various web pages.

Cookie Profiling – Although many websites employ cookie technology to capture some group and individual data, the identity of the website user remains anonymous. This is because a cookie can be only associated with a computer system and not an individual. Those who regard cookies as invasive erase them or block a web server from storing cookies on their computers. This makes it difficult, if not impossible, for marketers to acquire a consistent and individual profile. Without the need for cookies or the need for accessing client computer, UserTrends' technology collects, identifies, and tracks individual data transparently for profiling and marketing purposes.

7.   In particular, cookie profiling technology requires modification and customization of websites so that web servers can successfully access and store a cookie on an end user's computer. Further, customization and modifications are required to accommodate the cookie handling features of various browser applications used by an end user so that the cookie profiling technology could work effectively across all systems and platforms. Customization of each website or web server is associated with high professional service fees and requires more sophisticated computing resources (e.g., software and hardware).

8.   UserTrends' technology simply relies on preexisting email-associated resources and uses an email campaign that does not rely on customized web sites, sophisticated web servers, cookies or compatibility with cookie handling features of various browsers to collect highly individualized data. All that is required is an individual's email address and the individual's capability to receive email. The simplicity of UserTrends' technology provides a very efficient profiling technology that has convinced many UserTrends' clients to abandon other costly methodologies and solutions used previously.

9.   The data collected via a cookie profiling technology cannot be directly associated with a particular user or email because a cookie profiling technology only provides information about the computer used and not the particular user. Where more than one individual uses the same computer, or where an individual uses more than one computer, cookie profiling technology does not provide accurate behavior patterns that are so valuable for targeted marketing.

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10.   UserTrends' technology allows association of an email campaign data to each individual's email address and does not depend on anonymous data (i.e., data that provides an association of behavior to a specific computer rather than to an individual). Our studies have shown that as a direct result of using Usertrands' technology higher response rates and conversion rates have been achieved from email campaigns by our clients over time as illustrated in the following charts.
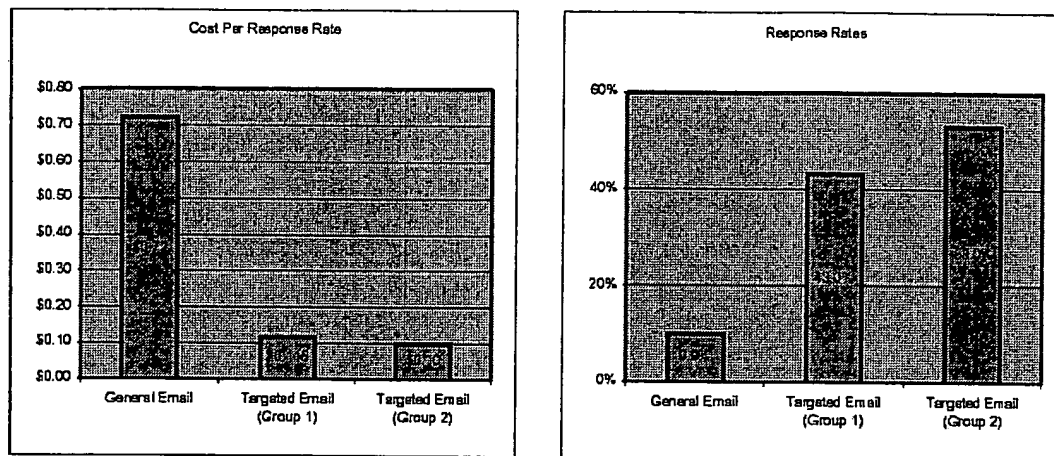
11.   Other email marketers have failed in targeting promotions to demonstrated web-site behavior down to the individual and therefore cannot accurately individualize the result of the information gathered from monitoring user movement on the Internet. UserTrends' technology addresses this long-felt need to solve the above deficiencies and problems. Utilizing UserTrends' technology targeted email promotions to individuals can be achieved, instead of executing mass marketing campaigns or marketing to large groups.

12.   Utilizing UserTrends' technology has reduced professional service requirements of UserTrends' clients by more than 50%. This cost saving and efficiency in particular is due to ease of implementation and use of the Usertrends' technology because it does not require special "customization" of server systems and website servers that other cookie or registration profiling technologies require.

13.   UserTrends has negotiated and is currently negotiating licensing arrangements with a number of current clients and other email marketing vendors to license UserTrends' proprietary technology. Majority of the license agreements are to vendors who "resell" the technology to

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13.   UserTrends has negotiated and is currently negotiating licensing arrangements with a
number of current clients and other email marketing vendors to license UserTrends' proprietary
technology. Majority of the license agreements are to vendors who "resell" the technology to
their clients. Cable and Wirless (CWP), Xpedite (PTEK), Boldfish, and eContacts are among the
vendors who have used UserTrends technology and have licensed or are considering licensing
the technology. Many clients of these vendors have already used UserTrends' technology. These
clients include HP, Compaq, Hawaiian Airlines, One World Networks, and CarrierPath.

14.   The above information provides objective evidence of unexpected results, commercial
success, the ability to meet a long-felt need where others have failed, and other factual evidence
in relation to UserTrends' technology, such as licensing activities. This evidence when
considered collectively indicates that UserTrends technology has been used to provide a distinct
and novel solution to overcome an insoluble problem associated with the older electronic
profiling technologies discussed above.

15.   I hereby declare that all statements made herein are of my own knowledge and true and
that all said statements are made on information and belief and are believed to be true; and
further that these statements were made with the knowledge that willful false statements and the
like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of
the United States Code,[1] and that such willful false statements may jeopardize the validity of the
application or any patent issuing thereon.

                                              Respectfully submitted,

Date: November 14, 2002   By: _____
                                             CEO, USERTRENDS

_____
[1]
   (a) Except as otherwise provided in this section, whoever, in any matter within the jurisdiction of the executive, legislative, or judicial branch of the
Government of the United States, knowingly and willfully -
   (1) falsifies, conceals, or covers up by any trick, scheme, or device a material fact;
   (2) makes any materially false, fictitious, or fraudulent statement or representation; or
   (3) makes or uses any false writing or document knowing the same to contain any materially false, fictitious, or fraudulent statement or entry;
shall be fined under this title or imprisoned not more than 5 years, or both.
   (b) Subsection (a) does not apply to a party to a judicial proceeding, or that party's counsel, for statements, representations, writings or documents submitted
by such party or counsel to a judge or magistrate in that proceeding.
   (c) With respect to any matter within the jurisdiction of the legislative branch, subsection (a) shall apply only to -
   (1) administrative matters, including a claim for payment, a matter related to the procurement of property or services, personnel or employment practices, or
support services, or a document required by law, rule, or regulation to be submitted to the Congress or any office or officer within the legislative branch; or
   (2) any investigation or review, conducted pursuant to the authority of any committee, subcommittee, commission or office of the Congress, consistent with
applicable rules of the House or Senate.

                                                     5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Bruce Eisen et al.
Assignee:	User Trends, Inc.
Title:	Electronically Distributing Promotional And Advertising Material Based Upon Consumer Internet Usage

Serial No.:	09/379,167	Filing Date:	08/23/99
Examiner:	John L. Young	Group Art Unit:	2162
Docket No.:	M-7729 US		

Assistant Commissioner of Patents
Washington, D.C. 20231

DECLARATION OF JAMES FEDOLFI

I, James Fedolfi, the undersigned declare as follows:

1.   I am the Vice President of EContacts Corporation. eContacts is a worldwide email marketing company with a place of business in Boston, Massachusetts. eContacts provides enabling solutions to companies involved in permission email marketing and traditional marketing. Our clients include Fortune 500 companies (e.g., HP, D&B, Red Herring, etc.) in a variety of industries.

2.   I have been in the email marketing industry with eContacts for approximately 4 years. In my capacity as the vise-president of eContacts, I make decisions involving the purchase, licensing, and utilization of technological tools to advance and promote eContacts' business and scope of influence in the current highly competitive electronic economic market. In that capacity, I am also involved in the management of business and financial operations of eContacts and overlook the development and success of eContacts and its client's marketing campaigns and evaluate the efficiency and effectiveness of technological tools used to achieve the same. Based on my background and experience in the industry, the scope of my duties as the Vice President of

eContacts, my personal experience with UserTrends technology, and my knowledge of other technologies in the email marketing industry, I provide you the following professional opinion.

3.   eConstacts has been using UserTrends' proprietary electronic consumer profiling technology since 2001 to track and profile consumer behavior. Prior to using UserTrends', eContacts had utilized other electronic profiling technologies to track particular consumer interests and profiles. Among all the technologies used by eContacts, UserTrends' technology was most the efficient and effective in providing our email marketing clients with a solution for profiling email respondents web site behavior and targeted email campaigns.

4.   UserTrends' technology is unique and superior to the other solutions and technologies we have used for the following reasons: (1) UserTrends' technology provides email marketers with data that cannot be otherwise collected with use of cookies (2) implementation of UserTrends' technology requires substantially less resources, (3) UserTrends' technology can be implemented with ease requiring no or minimal customization, (4) integration and use of UserTrends' technology is substantially less expensive than the other competing products in the market, (5) UserTrends' technology does not burden the targeted audience to go through a lengthy or inconvenient registration process, (6) UserTrends' technology accurately profiles a particular individual's interests and preferences by focusing on a known identifier associated with that particular individual, rather than using unanimous identifying means typically associated with a computer used by the individual.

5.   Competing electronic consumer profiling technologies generally capture individual data via an unfriendly registration process or by requiring a visitor logging in to the site or making a purchase. The e-marketing industry has generally used such data for mass direct marketing campaigns. In the case of data collected through a lengthy registration process, which only reveals a consumer's interest at a *particular moment* in time, aggregate profiling is usually necessary to determine what promotions to send the consumer. The following provides a list of various competing profiling methods and their disadvantages when compared to UserTrends' technology:

> Purchase Profiling – While purchase profiling is an accurate way of determining one interest of a customer, it isn't able to relate the customer's interests with other products

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they looked at but did not purchase. UserTrends' technology doesn't require a purchase or input of sensitive financial information to collect behavior data.

Registration Profiling – This requires individuals to take the time to fill out a long survey to provide marketers with some data regarding their particular interests. Unfortunately, the accuracy and reliability of such collected data are often questionable. These surveys can also often fail to weigh customer interests and only represent interests at one remote instance — although interests change, registrations remain the same. UserTrends' technology does not require a burdensome registration and allows updating users' interest data based on each individual user's activities on various web pages.

Cookie Profiling – Although many websites employ cookie technology to capture some group and individual data, the identity of the website user remains anonymous. This is because a cookie can be only associated with a computer system and not an individual. Those who regard cookies as invasive erase them or block a web server from storing cookies on their computers. This makes it difficult, if not impossible, for marketers to acquire a consistent and individual profile. Without the need for cookies, UserTrends collects, identifies, and tracks individual data transparently for profiling and marketing purposes.

6.   In particular, with respect to our clients, cookie profiling technology required our clients to modify and customize their websites so that their web servers could successfully access and store a cookie on an end user's computer. Further, customization and modifications were required to accommodate the cookie features of various browser applications used by an end user so that the cookie profiling technology could work effectively across all systems and platforms. Customization of each website or web server is associated with high professional service fees and requires more sophisticated computing resources (e.g., software and hardware).

7.   UserTrends' technology simply relies on preexisting email-associated recourses and uses an email campaign that does not rely on customized web sites, sophisticated web servers, cookies or availability of cookie handling features of various browsers to collect highly individualized data. All that is required is an individual's email address and the individual's capability to receive email. The simplicity of UserTrends' technology has provided eContacts with a very

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efficient profiling technology that has convinced eContacts to abandon other costly methodologies and solutions used previously.

8.   Unfortunately, even with all the required customization and other associated overhead, data collected via a cookie profiling technology cannot be directly associated with a particular user or email because a the cookie profiling technology only provides information about the computer used and not the particular user. Where more than one individual uses the same computer, or where an individual uses more than one computer, cookie profiling technology does not provide accurate behavior patterns that are so valuable for targeted marketing.

9.   UserTrends' technology allows us to associate email campaign data to each individual's email address and not depend on anonymous data (i.e., data that provides an association of behavior to a specific computer rather than to an individual). *The results have been astounding.* For example, as a direct result of using Usertrands' technology, we have achieved 25% to 35% higher response rates and conversion rates from email campaigns over time because a marketer is able to personalize and target promotions to individual preferences and demonstrated interest.

10.   UserTrends' technology has been so commercially successful, that we have been able to win business away from our competitors who cannot bring added value to the email marketers by providing them with highly individualized consumer data.

11.   Other email marketers have failed in targeting promotions to demonstrated web-site behavior down to the individual and therefore cannot accurately individualize the result of the information gathered from monitoring user movement on the Internet. UserTrends' technology addresses this long-felt need to solve the above deficiencies and problems. Utilizing UserTrends' technology now we can target email promotion to individuals instead of executing mass marketing campaigns or marketing to large groups.

12.   Utilizing UserTrends' technology, we have successfully reduced our professional service requirements by more than 50%. This cost saving and efficiency in particular is due to ease of implementation and use of the Usertrends' technology because it does not require special "customization" of server systems and website servers that other cookie or registration profiling technologies require.

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13. I hope that the above information will assist to shed some light on the usefulness of UserTrends' distinctive technology. I hereby declare that all statements made herein are of my own knowledge and true, and that all said statements are made on information and belief and are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code,[1] and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

Date: November 13, 2002

By: _____

James Fedolfi, VP eContacts, Inc.

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[1]

(a) Except as otherwise provided in this section, whoever, in any matter within the jurisdiction of the executive, legislative, or judicial branch of the Government of the United States, knowingly and willfully -

(1) falsifies, conceals, or covers up by any trick, scheme, or device a material fact;

(2) makes any materially false, fictitious, or fraudulent statement or representation; or

(3) makes or uses any false writing or document knowing the same to contain any materially false, fictitious, or fraudulent statement or entry;

shall be fined under this title or imprisoned not more than 5 years, or both.

(b) Subsection (a) does not apply to a party to a judicial proceeding, or that party's counsel, for statements, representations, writings or documents submitted by such party or counsel to a judge or magistrate in that proceeding.

(c) With respect to any matter within the jurisdiction of the legislative branch, subsection (a) shall apply only to -

(1)administrative matters, including a claim for payment, a matter related to the procurement of property or services, personnel or employment practices, or support services, or a document required by law, rule, or regulation to be submitted to the Congress or any office or officer within the legislative branch; or

(2)any investigation or review, conducted pursuant to the authority of any committee, subcommittee, commission or office of the Congress, consistent with applicable rules of the House or Senate.

Respectfully submitted,

By:

Date: November 19, 2002

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Interview Summary	**Application No.** 09/379,167 **Applicant(s)** EISEN ET AL.
	Examiner YOUNG **Group Art Unit** 3622

All participants (applicant, applicant's representative, PTO personnel):

(1) ERIC STAMBER (SPE)

(2) JASON FAR-HADIAN (APPLICANT'S REP.)

(3) BRUCE EISEN (APPLICANT)

(4) JAMES LUCAS (APPLICANT)

Date of Interview 6/23/03

Type: ☒ Telephonic ☐ Personal (copy is given to ☐ applicant ☐ applicant's representative).

Exhibit shown or demonstration conducted: ☒ Yes ☐ No. If yes, brief description:
INTERVIEW OUTLINE SUBMITTED BY MR. FAR-HADIAN (ATTACHED)

Agreement ☐ was reached. ☒ was not reached.

Claim(s) discussed: 1 (REPRESENTATIVE)

Identification of prior art discussed:
CAPIEL (US 6,449,634)

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:
SEE ATTACHED

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

1. ☒ It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph above has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a response to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW.

2. ☐ Since the Examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the interview unless box 1 above is also checked.

ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Examiner Note: You must sign and stamp this form unless it is an attachment to a signed Office action.

U.S. Patent and Trademark Office
PTO-413 (Rev. 10-95)   Interview Summary   Paper No. 28
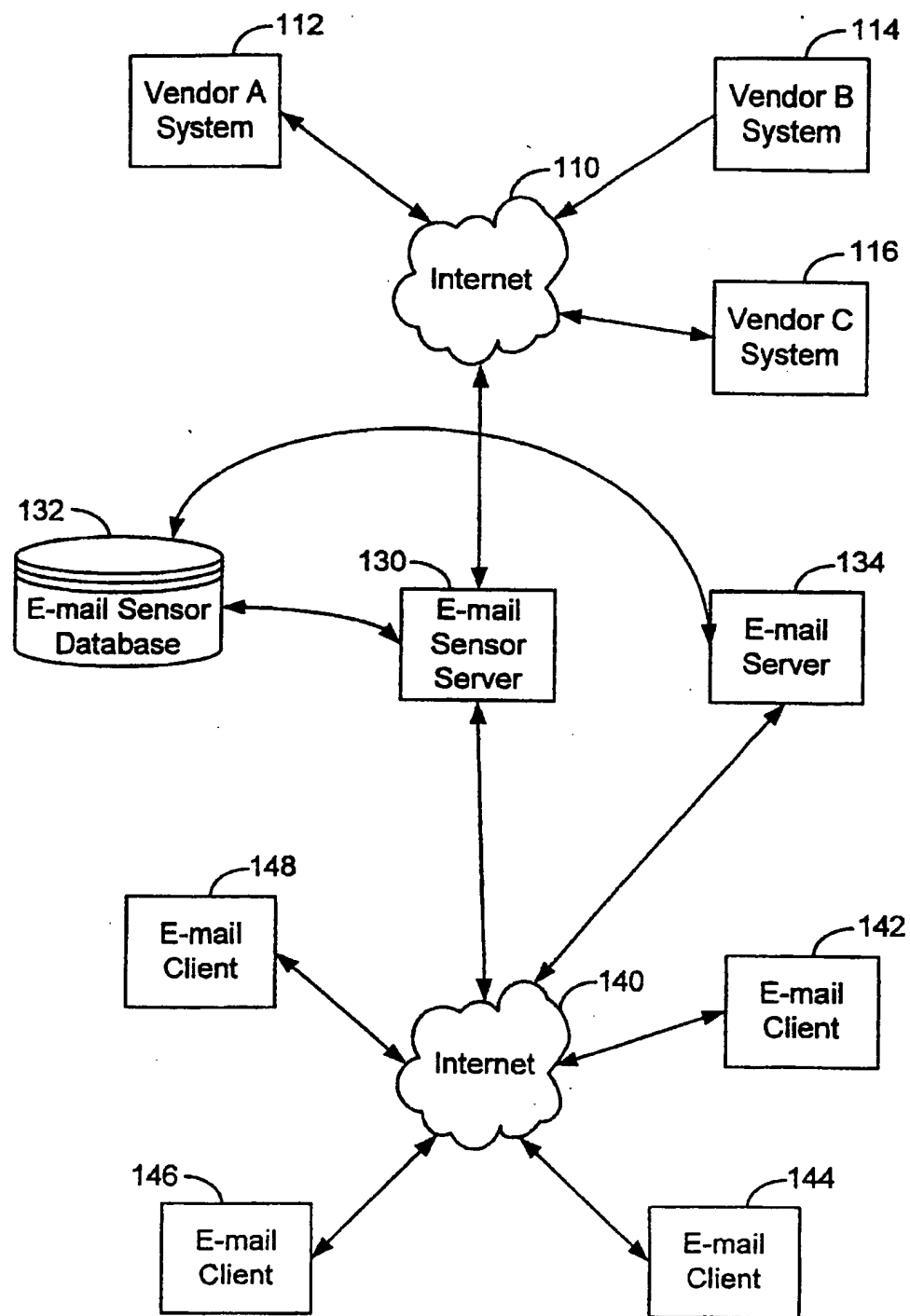
Attachment to the Interview Summary of Paper No. 28.

Mr. Far-hadian and Mr. Eisen began by describing the invention. It is directed to an e-mail that includes a link to a website. The link takes the form of that shown in Fig. 6B, namely http://www.mystore.com/?XXXX. The link includes a "unique identifier" (which is seen as "XXXX" in the link of Fig. 6B). This unique ID is associated with the e-mail address that the link is mailed to. The unique ID is also logged at the website when the link is "clicked" and is used to identify the user for tracking purposes at the website. This can be seen in element 703 in Fig. 7A where the unique ID shows up in the tracking details for that user.

This differentiates from the Image Tag of Capiel (the applied prior art) which is not "embedding a unique identifier within a website address" which is included "in an electronic mail message sent to the email recipient" (from claim 1). The Image Tag only identifies what type of file formats (HTML, Java, etc.) the e-mail of the user can process and does not have the claimed unique identifier and does not perform the claimed logging actions.

Mr. Far-hadian said that the applicant was considering either a request for reconsideration or possibly appeal at this point as the application has already been through numerous rejections.

If applicants decide to go the request for reconsideration route, the examiner will have to perform the mandatory updated search. Since prosecution has been lengthy, all effort will be made at identifying more pertinent prior art during the next search, which will include a search of relevant analogous network monitoring areas in Class 709, and at discussing this art in an interview environment in an effort to identify patentable limitations that can be drafted into a claim in order to put the case into condition for allowance.
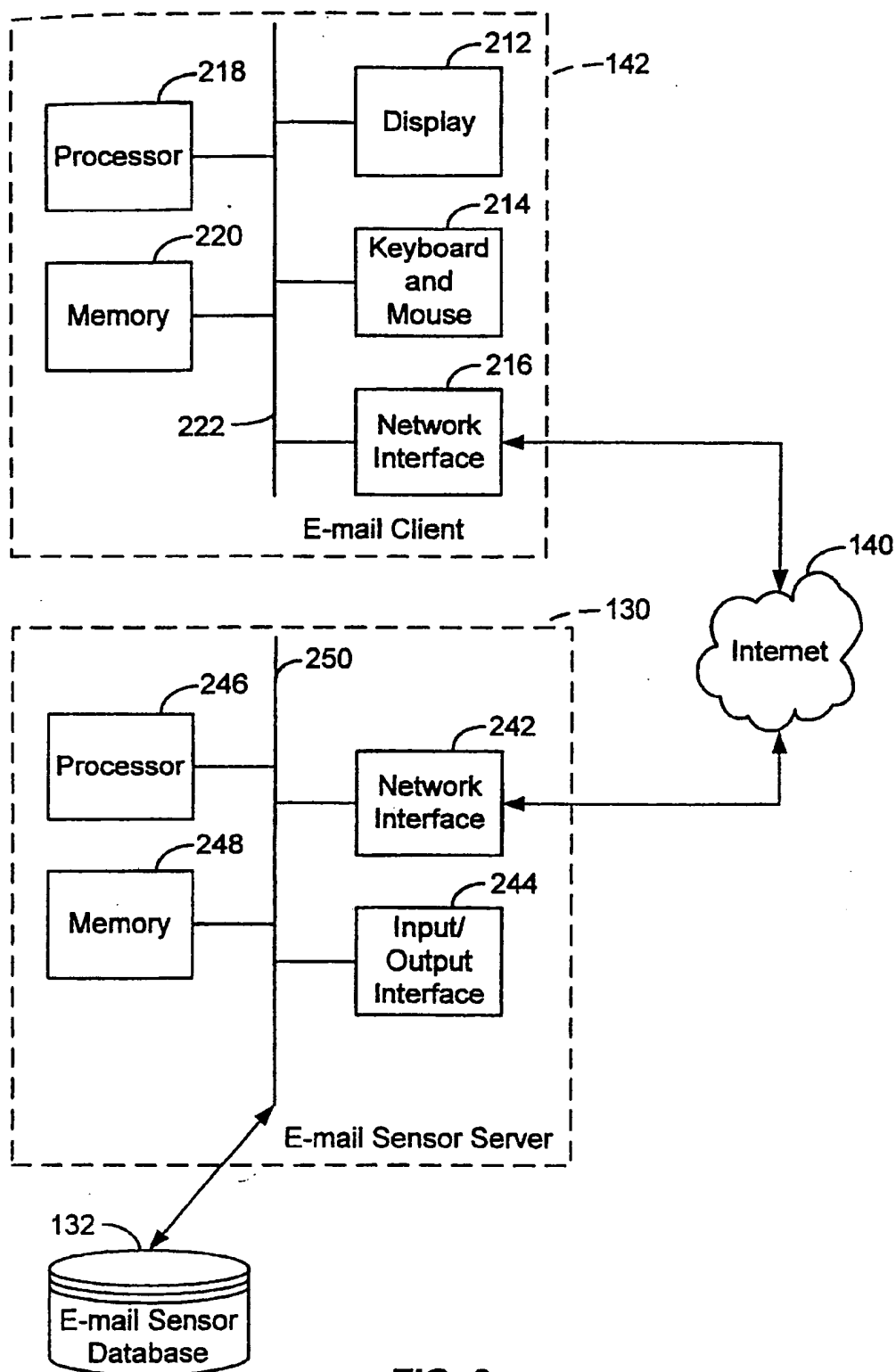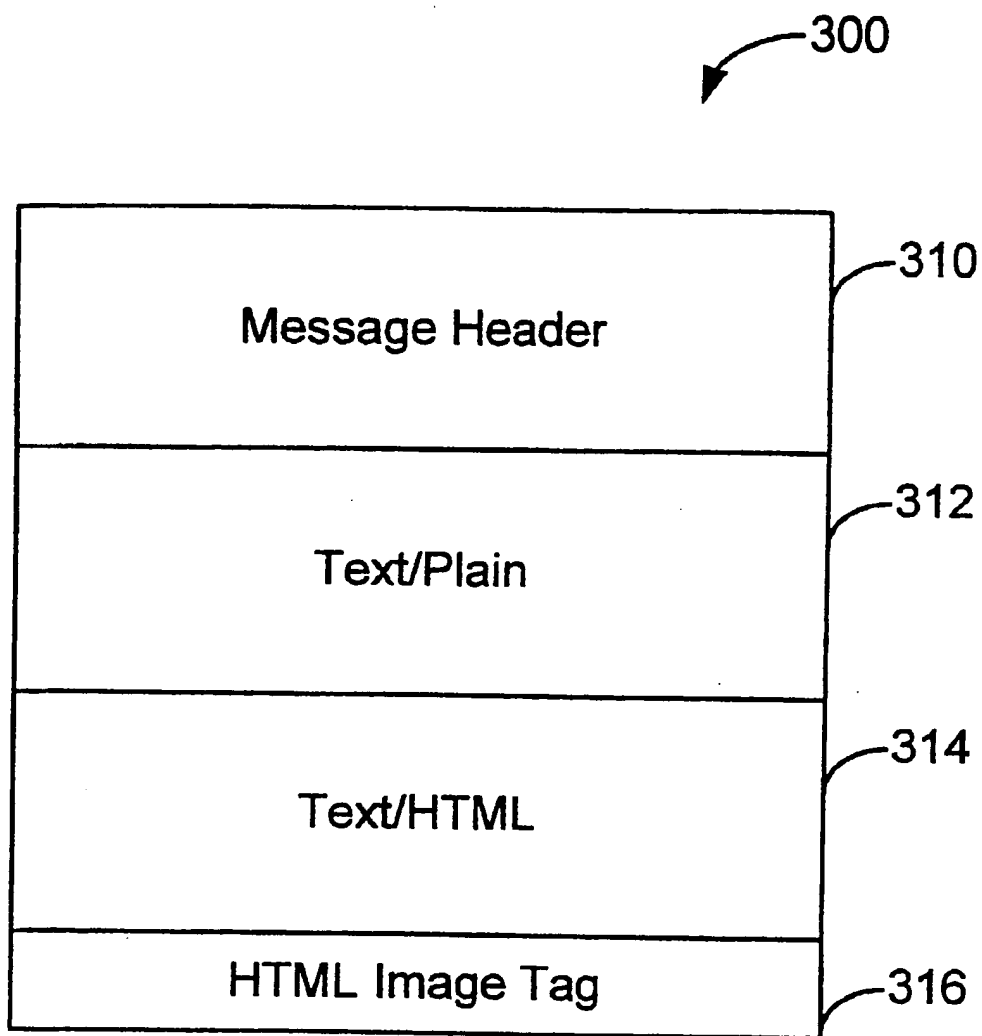
FIG. 1.

FIG. 2.

—300

Message Header

—310

Text/Plain

—312

Text/HTML

—314

HTML Image Tag

—316

FIG. 3.